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The Air Jordan Rules: Image Advertising Adds New Dimension to Right of Publicity—First Amendment Tension

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Cover Page Footnote

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Stephen McKelvey,* Jonathan Goins,† & Frederick Krauss‡

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INTRODUCTION

Every year, corporations spend on average nearly thirty-five billion dollars on sports-related marketing, ranging from stadium naming rights and promotional sponsorships, to commercials and endorsement deals.¹ In mining through some of the potential legal traps, corporate advertisers understand that utilizing the name, image, or likeness of athletes or celebrities in marketing and promotional campaigns requires some form of consent and compensation. Corporations hire lawyers for “advertising clearance”: to ensure that slogans, logos, and images are available for use, and that video and music in audio-visual recordings are otherwise licensed. The concept of getting permission or authorization is relatively straightforward. However, gray areas remain.

For example, what if an assemblage of athletes’ names, images, and biographical information are incorporated in a social media campaign—developed and promoted by a single company—that merely aggregates public information? Or what if a company produces a print advertisement seeking solely to congratulate an athlete for a career achievement? These questions lie at the core of two recent cases² in which courts have been challenged to determine where brand, or “image advertising,” resides at the nexus of the First Amendment, commercial speech, and the laws governing

¹ By way of example, Adidas recently signed National Basketball Association (“NBA”) player James Harden to a \$200 million shoe deal. Nike signed an eight-year partnership with the NBA worth roughly \$1 billion that begins with the 2017–2018 season. See Darren Heitner, *What a 13-Year, \$200 Million Deal Means to James Harden and Adidas*, FORBES (Aug. 13, 2015, 1:19 PM), <http://www.forbes.com/sites/darrenheitner/2015/08/13/what-a-13-year-200-million-deal-means-to-james-harden-and-adidas/> [https://perma.cc/KW83-YS88].

² This Article examines two cases: *Spitz v. Samsung Electronics America, Inc.*, No. BC 483475, 2013 WL 6816181 (Cal. Super. Ct. Jan. 10, 2013), and *Jordan v. Jewel Food Stores, Inc. (Jordan I)*, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), *rev’d*, 743 F.3d 509 (7th Cir. 2014).

the right of publicity.³ More specifically, the courts in these cases analyzed whether the use of athletes' likeness within these particular advertising contexts amounted to noncommercial speech (thus deserving of a higher degree of First Amendment free speech protection), or conversely, commercial speech (thus deserving of a lesser degree of First Amendment protection).

The plaintiffs in these cases are two of the most legendary athletes of our time. In *Spitz v. Samsung Electronics America, Inc.*,⁴ iconic Olympic swimmer Mark Spitz and numerous other notable Olympians sued Samsung over a Samsung-sponsored Facebook app⁵ that incorporated names, images, and biographical information of over 10,000 current and former Olympic athletes.⁶ While acknowledging that Samsung's sponsorship of the Olympic Genome Project Facebook app was intended to enhance its brand image, the court, in ruling for the defendants,⁷ classified Samsung's activity as noncommercial speech. In its ruling, the court relied heavily on the second case this Article addresses: *Jordan v. Jewel Food Stores (Jordan I)*.⁸

In *Jordan I*, Chicago-based drugstore chain Jewel-Osco ran a print advertisement in a national sports publication, congratulating Bulls' legend Michael Jordan on his enshrinement in the Basketball Hall of Fame.⁹ The advertisement mentioned Jordan's name and featured an image of a pair of sneakers with the number "23," and identified the drugstore by its own name, stylized logo, and slogan.

³ Although these two cases involve athletes, the issues apply as equally to non-sport celebrities. For this reason, the terms "athletes" and "celebrities" are used interchangeably throughout this Article.

⁴ *Spitz*, 2013 WL 6816181, at *1. Team Epic, the promotion agency that developed and managed Samsung's Genome Project, was also named in the lawsuit and took the lead in defending it.

⁵ An "app," shorthand for "application," is a software program, designed for a particular purpose, for a computer or other operating system. See Press Release, American Dialect Society, "App" 2010 Word of Year, as Voted by American Dialect Society (Jan. 7, 2011), <http://www.americandialect.org/American-Dialect-Society-2010-Word-of-the-Year-press-release.pdf> [https://perma.cc/6XKS-X4NJ].

⁶ Chuck Squatriglia, *Olympians Sue Samsung Over Facebook App*, WIRED (Apr. 26, 2012, 4:45 PM), <http://www.wired.com/2012/04/olympians-sue-samsung/> [https://perma.cc/FZH5-FMQ6].

⁷ The disposition of this case was based on an anti-SLAPP motion. See *infra* Part III.

⁸ *Jordan I*, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), *rev'd*, 743 F.3d 509 (7th Cir. 2014).

⁹ *Id.* at 1104.

Despite its obvious reference to Jordan's identity, the district court deemed the speech a congratulatory message, and noncommercial in nature.

The *Spitz* and *Jordan I* decisions confirmed that at least in some contexts—here, the aggregation of public information and congratulatory messaging—companies could legally incorporate athlete names and other indicia of identity in advertising campaigns that, while promoting the corporation itself, were not designed to sell a *specific* product or service.¹⁰ Such advertising, despite its inclusion of athletes' indicia, was deemed noncommercial and hence entitled to the full protection of the First Amendment.¹¹

This proposition, however, took a precedent-setting U-turn in February 2014, when the Seventh Circuit for the U.S. Court of Appeals reversed the district court's decision in *Jordan I*.¹² In *Jordan II*, the Seventh Circuit held that although Jewel-Osco's congratulatory advertisement did not promote or sell a *specific* product or service, its purpose as "image advertising" was enough to classify the advertisement as commercial speech, and thus eliminate Jewel-Osco's First Amendment noncommercial speech defense.¹³ As a result, Jordan was given the green light to resume pursuing his right of publicity claim under Illinois statutory law,¹⁴ in which he sought five million dollars in damages.¹⁵ Although the parties ultimately settled in November 2015¹⁶ and the facts of *Spitz* and *Jor-*

¹⁰ *Id.* at 1105.

¹¹ *Id.*

¹² *Jordan v. Jewel Food Stores (Jordan II)*, 743 F.3d 509 (7th Cir. 2014); see Darren Rovell, *Jordan Ruling Could Set Precedent*, ESPN (Feb. 20, 2014, 5:56 PM), http://espn.go.com/nba/story/_/id/10491664/michael-jordan-wins-appeal-endorsement-case-jewel-food-stores [<https://perma.cc/4UMK-5ZYV>].

¹³ *Jordan II*, 743 F.3d at 512.

¹⁴ 765 ILL. COMP. STAT. 1075/1 to 60 (2015).

¹⁵ Rovell, *supra* note 12.

¹⁶ See Jon Seidel, *Michael Jordan Settles with Jewel, Dominick's*, CHI. SUN TIMES (Nov. 22, 2015, 5:26 PM), <http://chicago.suntimes.com/news/7/71/1122975/grocery-chain-says-michael-jordan-settling-jewel-dominicks> [<https://perma.cc/FE4Z-KUL9>]. In addition to suing Jewel Food, Jordan also sued Dominick's Finer Foods in response to its congratulatory advertisement in the same *Sports Illustrated* commemorative issue. *Jordan v. Dominick's Finer Foods*, 115 F. Supp. 3d 950 (N.D. Ill. 2015). The Dominick's ad stated, "Congratulations Michael Jordan: You Are a Cut Above." *Id.* at 954. The bottom quarter of the ad, however, included a picture of a Rancher's Reserve steak and a two dollar coupon toward the purchase of a steak at any Dominick's location. *Id.* As with his

dan are distinguishable, these two cases have added a new and arguably conflicting dimension to the ongoing tension between the First Amendment freedoms of speech and expression and the right of publicity.

Part I of this Article begins by discussing the historical evolution of right of publicity law, from baseball cards to video games, followed by an examination of issues at the nexus of the right of publicity, trademark law, and the First Amendment. In Part II, we discuss the origins and evolution of the commercial speech doctrine, and the ongoing challenge in distinguishing non-commercial from commercial speech. In Part III, we examine the *Spitz* case in detail, including the rationale and reliance on the district court opinion in *Jordan I*. In Part IV, we discuss the Seventh Circuit's opinion in *Jordan II*, which rebukes the rationale in *Spitz* through its expansion of the U.S. Supreme Court's *Bolger* test.¹⁷ Specifically, the Seventh Circuit held that the failure to reference a specific product in the commercial-speech analysis "is far from dispositive, especially where 'image' or brand advertising rather than product advertising is concerned."¹⁸ In Part V we discuss the legal and practical implications of *Spitz* and *Jordan II*, especially if the Seventh Circuit's analysis of what constitutes commercial speech should be adopted by other jurisdictions. Ultimately, we conclude that the Seventh Circuit, while arguably broadening the scope of publicity rights through its re-interpretation of the *Bolger* test, non-

claim against Jewel Food, Jordan alleged violation of the Illinois Right of Publicity Act. *See id.* On summary judgment, the court orally ruled in favor of Jordan and left for a jury to decide damages. *Id.* Interestingly, the court in *Jordan I* hinted that, when comparing the Jewel Food and Dominick's ads, "[I]f somebody were to view one of the pages as an advertisement, it would be the Dominick's page." *Jordan I*, 851 F. Supp. 2d at 1110. The court's prediction came true when, in August 2015, a jury awarded Jordan an \$8.9 million judgment against Dominick's. Kim Janssen, *Jordan Says "It Was Never About the Money" After \$8.9M Jury Award*, CHI. TRIB. (Aug. 21, 2015, 9:46 PM), <http://www.chicagotribune.com/business/ct-michael-jordan-dominicks-case-0822-biz-20150821-story.html> [https://perma.cc/TW4F-PFQU]. In addition to settling with Jewel Food in November 2015, Jordan also settled the case with Dominick's, which was considering an appeal of the jury verdict. *See* Tony Briscoe, *Michael Jordan Reaches Settlement with Jewel, Dominick's*, CHI. TRIB. (Nov. 23, 2015, 7:00 AM), <http://www.chicagotribune.com/news/local/breaking/ct-michael-jordan-jewel-dominicks-settlement-met-20151122-story.html> [https://perma.cc/YU9F-J3DW].

¹⁷ *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983).

¹⁸ *Jordan II*, 743 F.3d at 519.

etheless shines a brighter light and sheds important guidance for companies seeking to use celebrity names and likeness in image advertising campaigns generally, and congratulatory ads in particular.

I. THE RIGHT OF PUBLICITY

A. *The Right of Publicity as a Right of Privacy*

The jurisprudence regarding the right of publicity grew initially out of the right of privacy over a century ago. The right of privacy's fundamental principle was, in essence, the right "to be let alone."¹⁹ In their famous law review article in 1890, Supreme Court Justice Louis Brandeis and scholar Charles Warren proposed that "the law must afford some remedy for the *unauthorized* circulation of portraits of private persons."²⁰ According to Supreme Court analysis of their text, "[T]he central thesis of the root article by Warren and Brandeis . . . was that the press was overstepping its prerogatives by publishing essentially private information and that there should be a remedy for the alleged abuses."²¹ Lamenting the press for invading the private sphere, "Warren and Brandeis advocated right of privacy to forbid the publication of idle gossip and restore 'propriety and dignity' to the press."²² The law, they asserted, protected the right of privacy to include the right of one's "inviolable personality"²³ as against the world:

We must therefore conclude that the rights, so protected, whatever their exact nature, are not rights arising from contract or from special trust, but are rights as against the world; and, as above stated, the principle which has been applied to protect these rights is in reality not the principle of private property, unless that word be used in an extended and

¹⁹ THOMAS M. COOLEY, *THE LAW OF TORTS* 29 (2d ed. 1888).

²⁰ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890) (emphasis added).

²¹ *Cox Broad. Corp. v. Cohn*, 420 U.S. 469, 487 (1975).

²² ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 1020 (5th ed. 2010) (internal citation omitted).

²³ Warren & Brandeis, *supra* note 20, at 205.

unusual sense. The principle which protects personal writings and any other productions of the intellect or of the emotions, is the right to privacy, and the law has no new principle to formulate when it extends this protection to the personal appearance, sayings, acts, and to personal relations, domestic or otherwise.²⁴

In 1960, noted scholar William L. Prosser expanded on the right “to be let alone” privacy principle by identifying four privacy torts,²⁵ and his conceptualization was incorporated nearly verbatim into the Second Restatement.²⁶ Prosser’s fourth privacy tort—appropriation of another’s name or likeness—is the principle behind what is now known as a right of publicity.²⁷

B. The Right of Publicity as a Right to Control

Leaving the historical application of the “privacy” theory of the right of publicity, courts and scholars began developing a more expansive definition. As Professor Melville B. Nimmer predicted, what the celebrity really wants is not necessarily protection against an unreasonable intrusion of privacy, but a fundamental right to control his or her commercial value.²⁸ “[A]lthough the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph and likeness reproduced and publicized without his consent or without remuneration to him.”²⁹ Now, courts in most jurisdictions uniformly hold

²⁴ *Id.* at 213.

²⁵ William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960). These included: (1) unreasonable intrusion upon another’s seclusion; (2) public disclosure of private facts; (3) false light invasion of privacy; and (4) appropriation of another’s name or likeness. *Id.*

²⁶ RESTATEMENT (SECOND) OF TORTS § 652A (AM. LAW INST. 1976).

²⁷ *See id.*; Prosser, *supra* note 25, at 389.

²⁸ 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:4 (4th ed. 2015) (quoting Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203–04 (1954)).

²⁹ *See id.*; *see also* Paulsen v. Personality Posters, Inc., 299 N.Y.S.2d 501, 508 (Sup. Ct. 1968) (“What such a [public] figure really seeks is a type of relief which will enable him to garner financial benefits from the pecuniary value which attaches to his name and picture.”).

that the right of publicity should be considered as a free standing right independent from the right of privacy.³⁰

Essentially, the right of publicity is a private cause of action under common or state law regarding the right of an individual to control the commercial use of his or her identity.³¹ There is no federal law applying the right of publicity.³² The principle is rooted in the cognizable property interest of a person's right against unauthorized commercial uses of his or her name or likeness.³³ The very core of the majority rule's application of the right of publicity is best articulated by trademark law's most renowned expert, J. Thomas McCarthy:

The right of publicity is the inherent right of every human being to control the commercial use of his or her identity. This legal right is infringed by unpermitted use which will likely damage the commercial value of this inherent right of human identity and which is not immunized by principles of free speech and free press. Infringement of the right of publicity is a commercial tort, and a form of unfair competition. The right of publicity is property, and is properly categorized as a form of intellectual property.³⁴

McCarthy's more expansive definition goes beyond just the right "to be let alone" (i.e., the right of privacy). He makes the right of publicity an "inherent right," which is likely more expansive than Brandeis, Warren, or even Prosser would have ever intended.

Thus, the right of publicity has evolved first from being "let alone," to the right to control, and finally, to not being commercially exploited. "Fundamentally, the right of publicity 'is the inherent right of every human being to control the commercial use of his or

³⁰ See, e.g., *Elvis Presley Int'l Mem'l Found. v. Crowell*, 733 S.W.2d 89 (Tenn. Ct. App. 1987).

³¹ RESTATEMENT (THIRD) OF CONTRACTS § 46 (AM. LAW INST. 1995).

³² For one of numerous articles that have advocated for passage of a federal right of publicity statute, see Risa J. Weaver, *Online Fantasy Sports Litigation and the Need for a Federal Right of Publicity Statute*, 9 DUKE L. & TECH. REV. 1 (2010).

³³ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

³⁴ 5 MCCARTHY, *supra* note 28, § 28:1.

her identity’”³⁵ and to prevent against economic exploitation.³⁶ As the entertainment and sports industries have grown, so too has case law on the rights of publicity. This right of publicity has developed in response to the “rise of mass advertising and the growing recognition that a celebrity’s imprimatur on a product or even association of a product with a celebrity’s persona enhances its appeal to consumers.”³⁷ Proving a right of publicity claim varies from state to state, but in general a plaintiff must demonstrate that: (1) one’s name, likeness or image, (2) was misappropriated without permission, and (3) which likely caused harm to the commercial value of that person.³⁸

C. State Right of Publicity Statutes

A right of publicity claim is a state-driven cause of action.³⁹ A plaintiff who sues based on a right of publicity claim is cognizable by state statutory law or common law. Judge Jerome Frank, in a 1953 case in the Second Circuit, coined the term “right of publicity,”⁴⁰ which prompted states to begin, as early as the 1970s, to enact statutes recognizing the right of publicity.⁴¹ As of April 2016, thirty-two states now recognize a right of publicity⁴²: twenty-one of which recognize it under common law, and eleven of which have codified it by state statute.⁴³ Some states, like California, recognize both a statutory and common law right of publicity.⁴⁴

³⁵ *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 988 n.6 (9th Cir. 2006) (quoting 5 MCCARTHY, *supra* note 28, § 28:1); *see also* 5 MCCARTHY, *supra* note 28, § 28:7 (noting that to trigger infringement of the right of publicity, the plaintiff must be “identifiable” from defendant’s unauthorized use).

³⁶ *See* MERGES, MENELL & LEMLEY, *supra* note 22 (“The modern right of publicity reflects two distinct rationales—one grounded in privacy and the other in economic exploitation.”).

³⁷ *Id.*

³⁸ 5 MCCARTHY, *supra* note 28, § 28:7.

³⁹ 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 6:1 (2d ed. 2015).

⁴⁰ *Id.* § 1:26 (describing the effect of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1951) on the development of the right of publicity).

⁴¹ *Id.* § 1:26 n.5 (listing states that enacted statutes “codifying to varying extents the rights of privacy and publicity”).

⁴² *Id.* § 6:3.

⁴³ *See* MERGES, MENELL & LEMLEY, *supra* note 22.

⁴⁴ *See Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 988–89 (9th Cir. 2006) (“California law recognizes both a statutory and common law right of publicity.”).

Uniformly, the right of publicity under these state laws is rooted in the cognizable property interest of a person's right against unauthorized commercial uses of his or her name, image, or likeness.⁴⁵ Some state statutes also recognize a right of publicity even to a private citizen. For example, in Georgia, the right of publicity encompasses the "rights of private citizens, as well as entertainers, not to have their names and photographs used for the financial gain of the user without their consent, where such use is not authorized as an exercise of freedom of the press."⁴⁶ Although the states offer similar levels of protections to living persons, right of publicity protections for deceased celebrities vary.⁴⁷

D. Evolution of Right of Publicity Case Law

Jurisprudence on right of publicity has evolved down two paths: right of publicity in context of commercial advertising and right of publicity in the context of expressive works.⁴⁸ The earliest case acknowledging the "right of publicity" was *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* in 1953.⁴⁹ In *Haelan*, the plaintiff had

⁴⁵ See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

⁴⁶ *Toffoloni v. LFP Publ'g Grp., LLC*, 572 F.3d 1201, 1206 (11th Cir. 2009) (quoting *Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 703 (Ga. 1982)).

⁴⁷ For example, California's right of publicity statute provides in part that:
Any person who uses a deceased personality's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the [decedent's successor or successors in interest], shall be liable for any damages sustained by the person or persons injured as a result thereof.

CAL. CIV. CODE § 3344.1(a) (2002). Other states such as New York, however, do not recognize a right of publicity post-mortem. See *Experience Hendrix, LLC v. Elec. Hendrix, LLC*, No. C07-0338 TSZ, 2008 WL 3243896, at *3-4 (W.D. Wash. Aug. 7, 2008) (holding that assignee of the estate of deceased rock musician Jimi Hendrix could own trademarks in his name and image for various goods and services even though there was no right of publicity because Hendrix died domiciled in New York, which did not recognize a post-mortem right of publicity) (citing N.Y. CIV. RIGHTS LAW § 51 (2015)).

⁴⁸ The focus within this Article is on the right of publicity in context of commercial advertising.

⁴⁹ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1951), cert. denied, 346 U.S. 816 (1953); 5 MCCARTHY, *supra* note 28, § 28:4 ("Judge Jerome Frank in 1953 was the first to coin the term 'right of publicity.'"). While as early as 1891 the U.S. Supreme Court recognized a person's right to the use of his or her own name, it was not

negotiated exclusive licenses from several Major League Baseball (“MLB”) players authorizing the use of their images on baseball cards that were included with packs of gum.⁵⁰ Defendant Topps, a rival company, sold its own gum with photographs of these same players.⁵¹ Haelan argued that the defendant had infringed upon Haelan’s exclusive right to employ the players’ pictures, even though the defendant knew of Haelan’s exclusive right of contract.⁵² Although ruling that New York’s privacy law statute did not extend to such uses, the court ruled that “a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing the picture, and that such a grant may validly be made ‘in gross’” under New York common law.⁵³ In resolving the dispute, the court created a new right, the right of publicity, to be used when celebrities, entertainers, and public figures claimed misappropriation or infringement of their privacy.⁵⁴ The *Haelan* court recognized that while celebrities may not suffer a high level of emotional harm when their identities are misappropriated, celebrities nevertheless need some type of protection from such activities.⁵⁵ Right of publicity law continued to evolve and broaden in scope through a string of cases involving athletes, including MLB player Art Shamsky,⁵⁶ auto racer Lothar Motschenbacher,⁵⁷ and basketball legend Kareem Abdul-Jabbar.⁵⁸ However,

coined or established as a “right of publicity.” *See* *Brown Chem. Co. v. Meyer*, 139 U.S. 540, 543 (1891) (holding that a person has a right to use his or her own name, and that it, by itself, is not transferable but conceded that a name is transferable when it accompanies the goodwill of a firm or product when sold).

⁵⁰ *Haelan Labs.*, 202 F.2d at 867.

⁵¹ *Id.*

⁵² *Id.* at 868.

⁵³ *Id.*

⁵⁴ *See id.*

⁵⁵ *Id.*

⁵⁶ *Shamsky v. Garan, Inc.*, 167 Misc. 2d 149 (N.Y. Sup. Ct. 1995) (holding that (1) sale of clothing without permission of individual players violated players’ statutory right of publicity; and (2) uniform player’s contract entered into by team members, permitting their pictures to be taken and used for publicity purposes, did not authorize club to use the team photo in contravention of their respective rights to publicity).

⁵⁷ *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (holding that a photograph depicting distinctive aspects of a race car driver’s car was an actionable misappropriation of the driver’s identity under California law).

⁵⁸ *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996). The *Abdul-Jabbar* court held that “by using Alcindor’s record to make a claim for its car . . . GMC has

recent high profile cases involving the emergence of fantasy gaming evinced a balancing of the right of publicity with the First Amendment and the fair use exception.⁵⁹

E. EA Sports Cases Broaden Scope of Right of Publicity

Three recent cases involving former college athletes—Rutgers football player Ryan Hart⁶⁰ and Arizona State quarterback Sam Keller⁶¹ against Electronic Arts (“EA”), and former UCLA basketball player Ed O’Bannon against the National Collegiate Athletic Association (“NCAA”)⁶²—have arguably served to further expand the right of publicity beyond its originally intended scope.⁶³ In 2009, Hart sued EA⁶⁴ in federal court in New Jersey, asserting that

arguably attempted to ‘appropriate the cachet of one product for another.’” *Id.* at 413 (quoting *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)). Additionally, the “right of publicity protects celebrities from appropriations of their *identity* not strictly definable as ‘name or picture.’” *Id.* at 415 (quoting *Motschenbacher*, 498 F.2d at 827).

⁵⁹ See *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007). The court held that “CBC’s First Amendment rights in offering its fantasy baseball products supersede the players’ rights of publicity.” *Id.*; see also *CBS Interactive, Inc. v. Nat’l Football League Players Ass’n, Inc.*, 259 F.R.D. 398, 417 (D. Minn. 2009) (holding that the First Amendment protects use of players’ names, statistics, and other information in fantasy football games).

⁶⁰ *Hart v. Elec. Arts, Inc. (Hart I)*, 808 F. Supp. 2d 757 (D.N.J. 2011), *rev’d*, 717 F.3d 141 (3d Cir. 2013).

⁶¹ *Keller v. Elec. Arts, Inc.*, 724 F.3d 1268 (9th Cir. 2013).

⁶² *O’Bannon v. Nat’l Collegiate Athletic Ass’n*, 7 F. Supp. 3d 955 (N.D. Cal. 2014). Although this case involved right of publicity claims, it was decided on antitrust grounds and thus not on point for our discussion here. In *O’Bannon*, co-defendants Electronic Arts (“EA”) and the Collegiate Licensing Corporation settled with the plaintiffs for forty million dollars in 2014. See Tom Farrey, *Players, Game Makers Settle for \$40M*, ESPN (May 31, 2014), http://espn.go.com/espn/otl/story/_/id/11010455/college-athletes-reach-40-million-settlement-ea-sports-ncaa-licensing-arm [https://perma.cc/C6PJ-VLSG].

⁶³ Legal scholars have been highly critical of the courts’ arguable expansion of publicity rights at the expense of First Amendment freedoms. See, e.g., Mark Conrad, *A New First Amendment Goal Line Defense—Stopping the Right of Publicity Offense*, 40 OHIO N.U. L. REV. 743 (2014); Martin H. Redish and Kelsey B. Shust, *The Right of Publicity and the First Amendment in the Modern Age of Commercial Speech*, 56 WM. & MARY L. REV. 1443, 1444 (2015) (arguing that “the courts’ willingness to incorporate established precepts of commercial speech protection into their right of publicity calculus is long overdue”).

⁶⁴ EA Sports, a division of EA, is the producer of the annual NCAA Football series of video games, which allow users to control avatars representing college football players as those avatars participate in simulated games. In EA Sports’ NCAA Football video game, the game features the ability to replicate each school’s entire team as accurately as

EA had used his image and likeness in its NCAA football video game (and in advertising promotions).⁶⁵ On summary judgment, the court ruled in favor of EA, noting that Hart's "identity" was limited to his likeness and biographical information.⁶⁶ Further, the court found that the use of Hart's likeness was sufficiently transformative to warrant First Amendment protection and that EA's First Amendment interests outweighed Hart's right of publicity in his likeness.⁶⁷ Interesting to this case study, the court found that the video game itself did not constitute commercial speech due, in large part, to the nature of the use of the image at the time of its purchase.⁶⁸ The court noted that Hart's image was not used in any advertisement in promoting the video game and that his image was only accessible after the commercial transaction was already complete; a buyer had to proactively play the game and select use of the Hart avatar, and even then, the buyer had the ability to utilize the artistic and creative aspects developed by EA to manipulate the player avatars such as Hart.⁶⁹

EA's victory was, however, short-lived. In May 2013, the Third Circuit reversed the lower court's decision.⁷⁰ After discussing the various tests previously established to determine right of publicity claims—the "transformative use" test, the "predominant use test," and the "relatedness" or so-called Rogers Test⁷¹—the court,

possible. Every real football player on each team included in the game has a corresponding avatar in the game with the player's actual jersey number and virtually identical height, weight, build, skin tone, hair color, and home state. *See generally* EA SPORTS, <https://www.easports.com> [<https://perma.cc/DP9F-BNJU>] (last visited Feb. 17, 2016).

⁶⁵ *Hart I*, 808 F. Supp. 2d at 760.

⁶⁶ *Id.* at 793–94.

⁶⁷ *Id.*

⁶⁸ *Id.* at 770.

⁶⁹ *Id.*

To be clear, it is not the user's alteration of Hart's image that is critical. What matters for my analysis of EA's First Amendment right is that EA created the mechanism by which the virtual player may be altered, as well as the multiple permutations available for each virtual player image. Since the game permits the user to alter the virtual player's physical characteristics, including the player's height, weight, hairstyle, face shape, body size, muscle size, and complexion.

Id. at 785.

⁷⁰ *Hart v. Elec. Arts, Inc. (Hart II)*, 717 F.3d 141 (3rd Cir. 2013).

⁷¹ *See id.* It is not within the scope of this Article to discuss in detail the elements and application of these various tests that jurisdictions have adopted to balance the right of

applying the transformative test, held that EA did indeed violate the plaintiff's right of publicity.⁷² The Ninth Circuit held similarly in *Keller v. Electronic Arts, Inc.*,⁷³ finding *Keller* to be "materially identical" to *Hart II*.⁷⁴ The *Keller* court ruled that EA's use of Keller's image was not sufficiently transformative for two reasons. First, Keller and his videogame counterpart shared enough characteristics to be virtually identical.⁷⁵ Second, EA had placed Keller's videogame character in the precise setting that the real Sam Keller derived his fame: the football field.⁷⁶ The court concluded that EA could not prove as a matter of law that its use of Keller's likeness was permissible based on the transformative use defense.⁷⁷ Thus, both the Third Circuit and Ninth Circuit agreed that EA's use of the plaintiffs' identities in NCAA football video games was not sufficiently transformative to receive First Amendment protection.⁷⁸ Even more recently, in January 2015, the Ninth Circuit affirmed the district court's decision in *Davis v. Electronic Arts, Inc.* to deny EA's motion to strike the complaint brought by former professional football players.⁷⁹ Although this recent spate of right of publicity

publicity with First Amendment concerns. For articles detailing each of these tests, see John Grady, Steve McKelvey & Annie Clement, *A New "Twist" for "The Home Run Guys": An Analysis of the Right of Publicity Versus Parody*, 15 J. LEGAL ASPECTS SPORT, no. 2, 2005, at 267, and Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471 (2003) (proposing, for the first time, the "predominant use" test, subsequently adopted by the Missouri court in *Doe v. TCI Communication*, 2002 Mo. App. LEXIS 1577 (Ct. App. July 23, 2002), *aff'd in part, rev'd in part*, 110 S.W.3d 363 (Mo. 2003), *cert. denied*, 2004 U.S. LEXIS 76 (2004)).

⁷² The Third Circuit reasoned that Hart's real world likeness and player statistics used by the game were the foundation for its realistic gameplay, therefore, EA had not sufficiently transformed Hart's likeness enough to be protected under the First Amendment. See *Hart II*, 717 F.3d at 168-70.

⁷³ *Keller v. Elec. Arts, Inc.*, 724 F.3d 1268 (9th Cir. 2013).

⁷⁴ *Id.* at 1278.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172 (9th Cir. 2015). Similar to the complaints in the NCAA Football video game cases, the plaintiffs allege that EA created over 6,000 accurate unauthorized likenesses of former players who appeared on more than 100 historic teams in Madden NFL games. *Id.* at 1176. The plaintiffs asserted claims for right of publicity, conversion, trespass to chattels, and unjust enrichment. EA moved to strike the complaint as a strategic lawsuit against public participation ("SLAPP") under California's anti-SLAPP statute. *Id.* The district court denied EA's motion on the

cases illustrates the arguable over-breadth of the right of publicity within expressive works,⁸⁰ ultimately our focus here turns to the use of athlete persona in the context of commercial advertising.

F. The Nexus of Right of Publicity and the First Amendment

The way a company uses an athlete's publicity in commerce, even without permission, can enable certain defenses, one of which is afforded by the First Amendment's guarantee of freedom of speech and freedom of expression. Pursuant to the First Amendment, "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances."⁸¹

grounds that the plaintiffs established a reasonable probability they would prevail on their claims. *Id.* at 1177. Ultimately, the Ninth Circuit struck EA's motion because they were unable to show that Madden NFL should be afforded First Amendment protection under any one of the five affirmative defenses they claimed. *Id.* at 1181.

⁸⁰ See Daniel Gervais & Martin L. Holmes, *Fame, Property, and Identity: The Scope and Purpose of the Right of Publicity*, 25 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* (2014). Despite the expansion of the right of publicity doctrine, some courts have recently held the line in cases involving the use of game footage and photos. See *Dryer v. Nat'l Football League*, 55 F. Supp. 3d 1181 (D. Minn. 2014). In *Dryer*, a group of retired NFL players who chose to opt out of a previous class action settlement with the NFL filed a lawsuit claiming that the NFL's use of video footage of players in television productions violated their publicity rights, caused consumer confusion, and unjustly enriched the league. *Id.* at 1186. In October 2014, the District Court of Minnesota granted summary judgment to the NFL, holding that the television productions recounting of professional football games were not commercial speech, and thus were fully protected by the First Amendment. *Id.* at 1193. Specifically, the court held that although the NFL had an economic interest in creating the productions, the league did not pay television networks to broadcast the productions, the productions used the players' footage merely because the games could not be described visually any other way, and the productions did not reference a separate product or service. *Id.*; see also *Marshall v. ESPN Inc.*, 111 F. Supp. 3d 815 (M.D. Tenn. 2015) (dismissing a lawsuit brought by several University of Tennessee football players against numerous media and broadcasting companies arguing that their rights of publicity have been infringed by broadcasters, and holding that the players in sporting events do not have publicity rights under common law in Tennessee, and moreover, that the plaintiffs failed to show that they had been deprived of any fundamental right).

⁸¹ U.S. CONST. amend. I.

The goal of the First Amendment is to secure the common good through the “free exchange of ideas.”⁸² As such, public discourse regarding topics like politics, religion, and other matters of opinion are considered noncommercial and, therefore, are afforded a certain level of constitutional protection. This level of scrutiny varies by the content of the speech. Content-based restrictions on speech are subject to a high bar of scrutiny and are only valid if the speech is necessary and tailored to serve a compelling state interest.⁸³ Conversely, content-neutral restrictions are subject to an intermediate tier of scrutiny. Here, courts must balance governmental interests against the speaker’s right to free expression.⁸⁴ The courts will rule “in favor of the government if its interests are important or substantial and do not burden the exercise of protected speech beyond what is necessary for their achievement.”⁸⁵ Furthermore, the courts must uphold economic regulations, especially those that disclose noncontroversial information, if they are related to legitimate government interests within reason and are not “unjustified or unduly burdensome.”⁸⁶ There are other types of speech that receive no constitutional protection.⁸⁷ Clearly, the First Amendment will preempt publicity rights when persona is used in

⁸² *Ashcroft v. Am. Civil Liberties Union*, 535 U.S. 564, 573 (2002) (quoting *Harte-Hanks Commc’ns, Inc. v. Connaughton*, 491 U.S. 657, 686 (1989)).

⁸³ *See* *Burson v. Freeman*, 504 U.S. 191, 198 (1992) (plurality opinion); *see also* *Boos v. Barry*, 485 U.S. 312, 334 (1988) (plurality opinion); *Bd. of Airport Comm’rs v. Jews for Jesus, Inc.*, 482 U.S. 569, 573 (1987).

⁸⁴ *See* *Members of the City Council v. Taxpayers for Vincent*, 466 U.S. 789, 804–05 (1984) (inquiring whether the government interest is sufficiently substantial to justify its content-neutral restriction).

⁸⁵ *See* Lucien J. Dhooze, *The First Amendment and Disclosure Regulations: Compelled Speech or Corporate Opportunism*, AM. BUS. L.J. 599, 605 (2014) (citing *Turner Broad. Sys., Inc. v. FCC*, 520 U.S. 180, 186 (1997); *United States v. O’Brien*, 391 U.S. 367, 377 (1968)).

⁸⁶ *See id.* (citing *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 651 (1985); *Nat’l Elec. Mfrs. Ass’n v. Sorrell*, 272 F.3d 104, 114–15 (2d Cir. 2001)).

⁸⁷ *See* *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 346–47 (1974) (defamation of private individuals); *Miller v. California*, 413 U.S. 15, 23–24 (1973) (obscenity); *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969) (inflammatory speech directed at inciting, and likely incite, imminent lawless action); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 278–80 (1964) (defamation of public officials or figures where the publisher knew the statement was false or acted with reckless disregard or its truth or falsity); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 573–74 (1942) (use of words in a public place likely to cause a breach of the peace).

the context of news reporting, commentary, entertainment, or works of fiction and nonfiction.⁸⁸ The challenge comes when the use of persona falls within the “for purposes of trade” provision of the Third Restatement of Unfair Competition.⁸⁹

Typically, an unauthorized use of a person’s identity will fall within one of two categories: the challenged use is either “communicative” or “commercial.” A communicative use is one in which the policy of free speech predominates over the right of the person to his identity.⁹⁰ Conversely, a “commercial” use of one’s publicity is much more likely to infringe upon the right of publicity.⁹¹ However, this distinction continues to provide a fertile ground for legal wrangling. Recent legal decisions and commentary document the ongoing tension between the right of publicity and the First Amendment.⁹² Within the sport context, relatively recent examples include two decisions involving online fantasy sports providers. In *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media L.P.*,⁹³ the Eighth Circuit affirmed the district court ruling that MLB players have rights of publicity in their names and performance statistics; however, the court also held that those

⁸⁸ 5 MCCARTHY, *supra* note 28, § 28.6.

⁸⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995). The Restatement clarifies “for purposes of trade” as a use in advertising the user’s goods or services, or on merchandise marketed by the user, or . . . in connection with services rendered by the user. *Id.* § 47.

⁹⁰ See *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (holding that a feature in a magazine using the name and photo of actor Dustin Hoffman was an entertainment story and not a misappropriation).

⁹¹ See *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (rejecting car manufacturer’s First Amendment defense that its use of Alcindor’s name was only “incidental” to conveying newsworthy sports information: “While Lew Alcindor’s basketball record may be said to be ‘newsworthy,’ its use is not automatically privileged. GMC used the information in the context of an automobile advertisement, not in a news or sports account.”).

⁹² See Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 904 (2004) (arguing that courts and legislatures have created a property-based right of publicity jurisprudence that goes beyond its original goals and encroaches on the traditional First Amendment guarantees afforded artistic and creative speech); see also *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003); *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. Sup Ct. 2003).

⁹³ *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007).

names and performance statistics were within the public domain and hence CBC's online fantasy game was protected under the First Amendment.⁹⁴ In a case involving football fantasy gaming, *CBS Interactive v. National Football League Players Association*⁹⁵ a Minnesota district court ruled in favor of CBS Interactive on essentially the same grounds as the Eighth Circuit in *CBC*.⁹⁶ In short, the courts have yet to develop a consistent approach in how to balance the right of publicity with First Amendment freedoms, a scenario made all the more challenging given the confusion that surrounds how we should define what constitutes commercial speech.⁹⁷

II. THE EVOLUTION OF THE "COMMERCIAL SPEECH" DOCTRINE

An examination of the commercial speech doctrine has historically encompassed two lines of inquiry. First, whether commercial speech is in fact subject to constitutional protection. The second line of inquiry—and continued source of confusion—is how commercial speech should be defined. In order to best understand the implications of the *Spitz* and *Jordan* cases, it is important to first understand the history and evolution of the commercial speech doctrine.

The notion of commercial speech emanates from the free speech provisions founded in the First Amendment.⁹⁸ The opera-

⁹⁴ *Id.* at 823.

⁹⁵ *CBS Interactive v. Nat'l Football League Players Ass'n*, 259 F.R.D. 398 (D. Minn. 2009).

⁹⁶ *Id.* at 417–18.

⁹⁷ *See infra* Part III.

⁹⁸ *See* Robert Sprague, *Business Blogs and Commercial Speech: A New Analytical Framework for the 21st Century*, 44 AM. BUS. L.J. 127 (Spring 2007). "There is . . . general consensus that the First Amendment's principal aim was to protect political deliberations . . ." *Id.* at 137.

⁹⁸ *Dhooge, supra* note 85, at 606 (citing *Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561–62 (1980) (concluding that "[c]ommerical expression not only serves the economic interest of the speaker, but also assists consumers and furthers the societal interest in the fullest possible dissemination of information")); *see also* *Va. State Bd. of Pharm. v. Va. Citizens Consumers Council, Inc.*, 425 U.S. 748, 763, 765 (1976) (determining that a "consumer's interest in the free flow of commercial

tive language of the First Amendment follows: “Congress shall make no law . . . abridging the freedom of speech.”⁹⁹ Despite the fact that the text only directly refers to Congress, “the U.S. Supreme Court has held the Due Process Clause of the Fourteenth Amendment makes the freedom of speech provision applicable to state and local governments.”¹⁰⁰ Accordingly, this extension of First Amendment protection allows for one to speak one’s mind without fear of persecution.¹⁰¹ Among those protections is the ability to express messages that involve religion, politics, and matters of public concern.¹⁰²

During the twentieth century, the notion began to emerge that speech, beyond that which was purely political, could also be afforded some lesser level of protection.¹⁰³ The Supreme Court first enunciated the concept of commercial speech in *Bigelow v. Virginia*,¹⁰⁴ holding that even speech that appears as paid commercial advertisements “is not stripped of First Amendment protection merely because it appears in that form.”¹⁰⁵ The Court, however, stopped short of deciding “the precise extent to which the First Amendment permits regulation of advertising that is related to ac-

information [is] . . . keen” and constitutional protection of commercial speech serves society’s interest in “enlighten[ed] public decisionmaking in a democracy”).

⁹⁹ U.S. CONST. amend. I.

¹⁰⁰ Caitlin Brandon, Note, *How a Grocery Store Grounded Air Jordan and Why Jordan Should Succeed in the Rematch: Redefining Commercial Speech for the Modern Era*, 47 IND. L. REV. 543, 545 (2014) (citing *Gitlow v. New York*, 268 U.S. 652, 666 (1925) (“[F]reedom of speech and of the press, which are protected by the First amendment from abridgement by Congress are among the fundamental personal rights and ‘liberties’ protected by the due process clause of the Fourteenth Amendment from impairment by the States.”)).

¹⁰¹ Scott Wellikoff, *Mixed Speech: Inequities that Result from an Ambiguous Doctrine*, 19 J. CIV. RTS. & ECON. DEV. 159, 159 (2004).

¹⁰² *Id.* at 160.

¹⁰³ One of the earliest Supreme Court decisions addressing commercial speech was *Valentine v. Christensen*, 316 U.S. 52 (1942), which upheld a local ordinance prohibiting distribution in the streets of commercial and business advertising materials. Although the Court’s holding seemed to indicate that commercial speech was not entitled to constitutional protection, it would later use *Bigelow v. Virginia*, 421 U.S. 809 (1975), to clarify that *Valentine* should not be read as an absolute prohibition of constitutional protection for commercial speech.

¹⁰⁴ *Bigelow*, 421 U.S. 809 (1975).

¹⁰⁵ *Id.* at 818 (citing *Pittsburgh Press Co. v. Human Rel. Comm’n*, 413 U.S. 376, 384 (1973)); see also *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964).

tivities the State may legitimately regulate or even prohibit.”¹⁰⁶ The Court would shortly thereafter directly address whether commercial speech warranted any constitutional protection in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*,¹⁰⁷ in which the constitutionality of Virginia’s prohibition against advertising the prices of prescription drugs was analyzed.

Although the Supreme Court did not provide an explicit test to determine what is considered commercial speech, it did provide insight as to what is *not* considered commercial speech: “Commercial speech is neither speech that solicits money nor speech that is sold for a profit. Speech is also not necessarily commercial just because money was spent to project it.”¹⁰⁸ Additionally, the Supreme Court concluded that there is a strong interest in the free flow of information for not only the individual consumer, but for society at large.¹⁰⁹ As a result, the Court held that the fact that speech is commercial does not alone deprive it of constitutional protection.¹¹⁰

Although *Virginia State Board of Pharmacy* expanded the commercial speech doctrine, the Supreme Court had yet to provide an explicit test for distinguishing commercial speech from noncommercial speech. The Court in *Central Hudson Gas & Electric Corp. v. Public Service Commission*¹¹¹ finally established a test to determine

¹⁰⁶ *Id.* at 825.

¹⁰⁷ 425 U.S. 748 (1976). For the first time, the Supreme Court acknowledged that the issue of whether there is a First Amendment exception for commercial speech “is squarely before us.” *Id.* at 761.

¹⁰⁸ *Id.*

¹⁰⁹ *Id.* at 762.

¹¹⁰ *Id.* at 773.

¹¹¹ *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557 (1980) (holding that the defendant state’s prohibition on the Public Service Commission’s right to advertise its services, despite its “commercial speech” nature, was unconstitutional). Subsequent to its decision in *Central Hudson*, the Supreme Court has offered further interpretations of the commercial speech doctrine in *Edenfield v. Fane*, 507 U.S. 761 (1993). In *Edenfield*, the Court held that it was not sufficient for the government merely to point to a considerable governmental interest and that the government must demonstrate that the regulation advanced the interest in a direct and material way. In *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996), the Court held that there was even less reason to start from the strict scrutiny review that the First Amendment generally required when a state entirely banned the dissemination of truthful, non-misleading commercial messages for reasons not associated with the protection of a fair bargaining process.

the difference between commercial and noncommercial speech. First, the Court defined commercial speech as an “expression related solely to the economic interests of the speaker and its audience.”¹¹² Next, the Court created a four-part test to determine whether the commercial speech in question is protected by the First Amendment.¹¹³ The four-part test examines: (1) whether the expression is protected by the First Amendment, meaning that it concerns lawful activity that is not misleading; (2) whether the asserted governmental interest is substantial; if both of the first two parts are satisfactorily met then (3) whether the regulation directly advances the governmental interest asserted; and (4) whether it is more extensive than is necessary to serve that interest.¹¹⁴ The Court held that “[t]he State must assert a substantial interest to be achieved by restrictions on commercial speech. Moreover, the regulatory technique must be in proportion to that interest.”¹¹⁵

In 1983, the Supreme Court, in *Bolger v. Youngs Drug Products Corp.*,¹¹⁶ provided further guidance for distinguishing between commercial and noncommercial speech. In *Bolger*, a manufacturer and distributor of contraceptives brought an action challenging a federal statute prohibiting unsolicited mailing of contraceptive advertisements.¹¹⁷ The primary issue was whether the manufacturer’s pamphlets contained commercial speech, that is “speech which does ‘no more than propose a commercial transaction.’”¹¹⁸ The

¹¹² *Cent. Hudson Gas*, 447 U.S. at 561.

¹¹³ *Id.*

¹¹⁴ *Id.* at 561–66.

¹¹⁵ *Id.* at 564. In order to determine the scope of proper regulation of commercial speech, the Supreme Court created a four-step analysis:

We must (1) determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask (2) whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine (3) whether the regulation directly advances the governmental interest asserted, and (4) whether it is not more extensive than is necessary to serve that interest.

Id. at 566.

¹¹⁶ *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983).

¹¹⁷ *Id.* at 67–68.

¹¹⁸ *Id.* at 67 (quoting *Va. State Bd. of Pharm. v. Va. Citizens Consumers Council, Inc.*, 425 U.S. 748, 762 (1976)).

Court noted that the manufacturer's informational pamphlets could not be characterized merely as proposals to engage in commercial transactions, and that their proper classification as commercial or non-commercial speech presented a closer question.¹¹⁹ "The mere fact that these pamphlets are conceded to be advertisements clearly does not compel the conclusion that they are commercial speech."¹²⁰ Similarly, the reference to a specific product does not by itself render the pamphlets commercial speech.¹²¹ "And finally, the fact that the manufacturer has an economic motivation for mailing the pamphlets would clearly be insufficient by itself to turn the materials into commercial speech."¹²² Thus, the Court identified specific factors that have evolved, through subsequent interpretations and applications by lower courts, into the accepted test to determine if the speech in question is commercial: (1) whether the communication is an advertisement, (2) whether the communication makes reference to a specific product or service, and (3) whether the speaker has an economic motivation for the communication.¹²³ This three-part test became well-known as the *Bolger* test.¹²⁴

¹¹⁹ *Id.*

¹²⁰ *Id.* (citing *N.Y. Times v. Sullivan*, 376 U.S. 254, 265-66 (1964)).

¹²¹ *Id.* (citing *Associated Students v. Att'y Gen.*, 368 F. Supp. 11, 24 (C.D. Cal. 1973)).

¹²² *Id.* at 67 (citing *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975)).

¹²³ *Id.*

¹²⁴ According to a recent LexisNexis search, over 578 cases since 1983 have cited the *Bolger* test in a wide variety of factual contexts, including over thirty-three Supreme Court decisions and over 167 decisions from the U.S. Courts of Appeals. Despite the plethora of jurisprudence applying or adopting the *Bolger* test, there is a growing trend of commentators that have proposed different tests. *See, e.g.*, Brandon, *supra* note 100, at 557. Brandon proposes an original three-part test to distinguish commercial speech from noncommercial speech. The elements of the test are as follows: "(1) identify the speaker and weigh the speaker's motivations, (2) look at the content of the speech itself, and (3) assess how the average consumer or reader would view the speech." *Id.* Specifically, Brandon says the first step is to determine the motive of the speaker. *Id.* Next, one must look to not only the content of the speech, but the mode within which it is being delivered. *Id.* at 557-59. Also, it is essential to take into account the "use of intellectual property rights of others by the speaker." *Id.* at 558. Finally, the test would look towards how the average consumer would view the speech. *Id.* at 559-60. Brandon emphasizes that this factor should analyze the speech broadly, rather than with a narrow focus. *Id.* at 559. She argues that courts should look at several factors, including:

[W]ould the consumer gain some type of truth or objectively useful information from the speech . . . ; is there a trademark or trade name used which would trigger a commercial association in the mind of the

Courts have grappled most often with situations in which the challenged communication contains elements of both commercial and noncommercial speech. One of the most high profile cases to address this issue was *Kasky v. Nike, Inc.*¹²⁵ Nike argued that advertisements placed in newspapers, the distribution of press releases, and the mailing of letters to athletic directors at major universities—all of which were designed to counter criticism of the working conditions of overseas factories manufacturing Nike products—did not amount to commercial speech, and hence were fully protected under the First Amendment free speech provisions of the U.S. and California constitutions.¹²⁶ Noting that the U.S. Supreme Court “has not adopted an all-purpose test to distinguish commercial from noncommercial speech under the First Amendment,”¹²⁷ the California Supreme Court likewise declined to do so.¹²⁸ Instead, the California court created a limited-purpose test as to whether particular speech may be subjected to laws aimed at preventing false advertising or other forms of commercial deception; the test consisted of three elements: the speaker, the intended audience, and the content of the message.¹²⁹

In holding for the plaintiff, the court concluded that in situations where there is a commercial speaker, an intended commercial audience, and commercial content in the message, the speech should be deemed to be commercial in nature.¹³⁰ The court was

consumer, allowing the consumer to believe the speaker is speaking commercially; or possibly would a persuaded reader be more likely to engage in a commercial transaction with the speaker after viewing the speech?

Id. at 560.

¹²⁵ *Kasky v. Nike, Inc.*, 45 P.3d 243 (Cal. 2002), *cert. denied*, *Nike, Inc. v. Kasky*, 123 S. Ct. 2554 (2003).

¹²⁶ A determination that Nike’s communications were not commercial speech would bar the claims of unfair competition and false advertising brought by plaintiff Kasky, a private California citizen. *Id.* at 262.

¹²⁷ See generally Deborah J. LaFetra, *Kick it Up a Notch: First Amendment Protection for Commercial Speech*, 54 CASE W. RES. L. REV. 1205 (2004); David C. Vladeck, *Lessons from a Story Untold: Nike v. Kasky Reconsidered*, 54 CASE W. RES. L. REV. 1049 (2004).

¹²⁸ *Kasky*, 45 P.3d at 262.

¹²⁹ *Id.*

¹³⁰ *Id.* at 256–58. The court specifically held that Nike’s statements constituted commercial speech because: (1) Nike, being engaged in commerce, is a commercial speaker; (2) its statements were addressed directly to actual and potential purchasers of

also challenged with how to handle commercial speech that was intermingled with what would otherwise be constitutionally-protected noncommercial speech.¹³¹ Relying on *Bolger*, the court held that Nike could not immunize itself simply by including references to public issues, especially where the alleged false advertising and misleading statements all related to the commercial portions of the speech in question.¹³² The court further held that, because modern public relations campaigns are often designed to increase sales and profits by enhancing the image of the speaker, the press release amounted to commercial speech.¹³³ The court thus concluded that speech is not necessarily entitled to the full protection under the First Amendment when it incorporates elements of both commercial and noncommercial speech. With the Supreme Court's decision to withdraw its writ of certiorari in *Kasky*, an opportunity was missed to address a critical issue related to commercial speech: whether statements made by commercial enterprises which do not directly promote a product or service, but instead comment on social issues and general business practices, are commercial speech.¹³⁴ Hence, the stage remained set for the latest legal skirmish over how to define commercial speech, as illustrated in the foregoing analysis of the *Spitz* and *Jordan* cases.

its products (a commercial audience); and (3) its representations of fact were of a commercial nature because it described its own labor policies and the practices and working conditions in factories where its products were made. *Id.* at 258.

¹³¹ Nike, relying on *Board of Trustees of the State University of New York v. Fox*, 492 U.S. 474 (1989), argued that because its commercial speech was “inextricably intertwined” with the noncommercial communications, its communications should be deemed noncommercial in its entirety. Citing *Fox*, the court stated that “[n]o law required Nike to combine factual representations about its own labor practices with expressions of opinion about economic globalization. . . .” *Id.* at 260. Although the U.S. Supreme Court initially granted a writ of certiorari to hear an appeal, it subsequently dismissed the writ as improvidently granted.

¹³² *Id.* at 260 (citing *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68 (1983)).

¹³³ We see much the same rationale being applied by the Seventh Circuit in *Jordan II* in its application of the “modern” purpose of brand advertising. See *infra* Part V.

¹³⁴ See Robert M. O’Neil, *Nike v. Kasky—What Might Have Been*, 54 CASE W. RES. L. REV. 1259, 1259–60 (2004) (contending that *Nike, Inc. v. Kasky* provided the Supreme Court an opportunity to clarify the “increasingly confusing” commercial speech doctrine).

III. *SPITZ* AND ITS RELIANCE ON *JORDAN I*

The 2012 Summer Olympic Games in London were widely promoted as “the first social media Games.”¹³⁵ For example, more than 220,000 fans “liked” a video highlight posted on Facebook of gymnast Gabby Douglas, and Olympians typically generated thousands of new followers immediately after winning gold medals.¹³⁶ Further, athletes shared their Olympic experiences via various social media platforms such as Facebook, Twitter, and Instagram.¹³⁷ In addition to the athletes themselves, corporate sponsors also embraced the power of social media. One of the most high profile examples was Samsung’s Olympic Genome Project, a Facebook app that enabled consumers to explore their personal connections with U.S. Olympians and to share this information with their friends in other online communities.¹³⁸ The Genome Project was created on the notion that Americans “have long had a strong desire to get closer to the Olympians they cheer for, and that current social media has given rise to an opportunity to do so.”¹³⁹ Samsung’s Genome Project, developed in cooperation with the United States Olympic Committee, went live in April 2012, and offered fans of the upcoming Summer Games “a unique interactive Facebook experience to the end-user.”¹⁴⁰ Once the user accessed the app, a splash screen appeared and depicted the Samsung logo behind it. As the user further explored the app, it requested consent to access the user’s Facebook profile. The app then matched the information in the user’s Facebook profile to publicly available information of some 8,200 athletes included within the Genome Project database,

¹³⁵ Tripp Mickle, *Olympic Snapshots: How Will the London Games Be Remembered?* SPORTS BUS. DAILY (Aug. 13, 2012), <http://www.sportsbusinessdaily.com/Journal/Issues/2012/08/13/Olympics/Olympic-snapshots.aspx> [https://perma.cc/6HK9-EMQV].

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ See *infra* note 141.

¹³⁹ Notice of Motion to Strike Plaintiffs’ First Amended Complaint Pursuant to California Code of Civil Procedure 426.16 at 4, *Spitz v. Samsung Elecs. Am., Inc.*, No. BC 483475, 2013 WL 6816181 (Cal. Super. Ct. Jan. 10, 2013) [hereinafter Notice of Motion to Strike]. Ironically, Samsung was the defendant in an earlier landmark lawsuit, *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (1993), that broadened the right of publicity by “arguably granting Vanna White a monopoly in being a blond co-host or sidekick on Wheel of Fortune.” Gervais & Holmes, *supra* note 80, at 193.

¹⁴⁰ Notice of Motion to Strike, *supra* note 139, at 5.

resulting in an instantaneous display of those Olympians with whom the app user shared commonalities such as hometown, school, and favorite song.¹⁴¹

The user could discover additional connections by participating in quizzes. The Genome Project then presented the user's connections in a virtual "map," whereby a "Connection Page" displayed the user at the center and his or her connections surrounding her.¹⁴² Since it was created via the user's personal information, each "Connection Page" was thus unique to each user. Once the user learned that particular athletes were connected with her, she could discover more about the Olympians, view their "profiles," and further explore commonalities.¹⁴³ These profiles included such things as the athlete names, publicly available biographical information, and photographs.¹⁴⁴

The Genome Project also served as an online community wherein the user could share their connections and compete with other users.¹⁴⁵ For instance, the app identified the user's Facebook friends who were also shared connections with that particular athlete.¹⁴⁶ Additionally, the user could accumulate points by interacting within the community to build their connections, and could also more intimately follow their favorite athletes by connecting to their Facebook News Feeds, personal websites, and Twitter accounts.¹⁴⁷

As inventive, interactive, and engaging as the Genome Project was, Samsung was quick to learn that using Olympic athletes in social media was not without its legal risks.¹⁴⁸ Four months prior to the Opening Ceremonies of the London Games, twenty current and former Olympians¹⁴⁹ sued Samsung and its promotion agency,

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.* The Connections page and profiles were the only parts of the application in which an athlete's name, photograph or biographical information was displayed. *Id.* at 6.

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ Opposition to Team Epic LLC's Motion to Strike Plaintiffs' First Amended Complaint, *Spitz v. Samsung Elecs. Am., Inc.*, No. BC 483475, 2013 WL 6816181 (Cal. Super. Ct. Jan. 10, 2013) [hereinafter Opposition to Motion to Strike]. In addition to lead plaintiff Mark Spitz, the other plaintiffs consisted of a "who's who" of Olympic

Team Epic, in a California superior court, alleging, inter alia, a violation of their right of publicity under common law and statutory misappropriation of their names and images.¹⁵⁰ In response, the defendants immediately filed an anti-SLAPP motion: a motion, unique to the state of California, designed to limit litigation that would impinge the First Amendment.¹⁵¹ Specifically, the anti-SLAPP statute provides:

A cause of action against a person arising from any act of that person in furtherance of the person's right of petition or free speech under the United States or the California Constitution in connection with a public issue shall be subject to a special motion to strike, unless the court determines that the plaintiff has established that there is a probability that the plaintiff will prevail on the claim.¹⁵²

The purpose of the anti-SLAPP statute is to “encourage participation in matters of public significance by allowing a court to promptly dismiss unmeritorious actions or claims brought to chill

champions including: Greg Louganis, Jackie Joyner-Kersey, Janet Evans, Dara Torres, Amanda Beard, Aaron Peirsol, Jason Lezak, Cullen Jones, Phil Dalhausser, Bradley Schumacher, Jessica Hardy, Brooke Bennett, Kristy Kowal, Christopher Burckle, Caroline Burckle, Eric Shanteau, Kim Vanderberg, Margaret Hoelzer, and Brittany Hayes. All were or are represented by the same agent, Evan Morgenstein. *Id.*

¹⁵⁰ Section 3344(a) of the California Civil Code provides:

(a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof.

CAL. CIV. CODE § 3344(a) (West 2012).

¹⁵¹ Notice of Motion to Strike, *supra* note 139, at 6 (citing *Braun v. Chronicle Publ'g Co.*, 52 Cal. App. 4th 1036, 1042 (1997)). See CAL. CIV. PROC. CODE § 425.16 (West 2015). California's anti-SLAPP statute was enacted “to nip SLAPP litigation in the bud” by quickly disposing of claims that target the exercise of free speech rights. See *Braun*, 52 Cal. App. 4th at 1042.

¹⁵² CAL. CIV. PROC. CODE § 425.16(b)(1).

another's valid exercise of the constitutional rights of freedom of speech."¹⁵³

Although the *Spitz* decision was lightly-publicized—especially given the name renown of the plaintiffs coupled with the public appeal of the Olympics—it nonetheless held important ramifications for how athletes could be utilized within social media platforms. The Superior Court of the State of California for the County of Los Angeles ruled in favor of Samsung and Team Epic on its anti-SLAPP motion, based on its decision that Samsung's Facebook app qualified as fully-protected noncommercial speech.¹⁵⁴ As Judge Kwan held, the display of the plaintiff's names, images, and biographical information “constituted written statements made in a public forum and in connection with issues of public importance.”¹⁵⁵ Further, Judge Kwan held that the challenged speech contained in the Genome Project was non-commercial speech fully protected by the First Amendment, especially given that all the information was already readily available to the public.¹⁵⁶ Judge Kwan held that the Olympic Genome Project did not propose a commercial transaction, nor did it contain advertisements for specific Samsung products.¹⁵⁷ As she ruled:

The fact that the logo “Created by Samsung” could be seen in the application does not convert the Olympic Genome Project into commercial speech. . . . The logo merely served to identify Samsung as the creator of the Olympic Genome Project. Further, no specific product was specifically refe-

¹⁵³ *Id.* § 425.16(a). An anti-SLAPP analysis involves a two-step process. First, the defendant must make a prima facie showing that the plaintiff's suit is subject to the statute by showing his or her challenged acts were taken in furtherance of his or her constitutional rights of petition or free speech *in connection with a public issue*. *Id.* § 425.16(b)(1). If the defendant satisfies this first step, the burden shifts to the plaintiff to demonstrate there is a reasonable probability he or she will prevail on the merits at trial. *Id.*

¹⁵⁴ See *Spitz*, 2013 WL 6816181, at *1.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.* The question of whether speech is properly characterized as commercial or non-commercial is a question of law. The court cited the *Jordan I* case for the proposition that “[s]peech that does no more than propose a commercial transaction is what defines commercial speech.” *Id.*

¹⁵⁷ *Id.*

renced or mentioned. Moreover, even if the display of the Samsung logo could somehow be viewed as introducing minimal elements of commercialism, those elements are intertwined with and overwhelmed by the message's non-commercial aspects, thereby rendering the entirety of the Olympic Genome Project non-commercial Finally, the fact that Samsung may have acted with economic motivation . . . does not, in and of itself, turn the application and its content into commercial speech.¹⁵⁸

Judge Kwan's analysis chiefly focused on the fact that all of the information used by Samsung was already in the public domain. To support this, she relied heavily on both *Gionfriddo v. Major League Baseball*¹⁵⁹ and *CBC*.¹⁶⁰ *Gionfriddo* involved a group of rather unknown former MLB players (including outfielder Al Gionfriddo)¹⁶¹ who sued the MLB for alleged right of publicity violations based upon the league's inclusion of the players' names and playing statistics in its All-Star Game and World Series magazines and on its website. The district court in *Gionfriddo* held that use of the players' names and statistics were (1) in connection with news, public affairs, or sports accounts, and (2) constituted publication of matters of public interest.¹⁶² The California Court of Appeals affirmed, concluding that the information conveyed was factual data and statistics about the players and that MLB was simply making historical facts available to the public.¹⁶³

¹⁵⁸ *Id.* at 3 (citing *Jordan I*, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), *rev'd*, 743 F.3d 509 (7th Cir. 2014); *Bernardo v. Planned Parenthood Fed'n of Am.*, 115 Cal. App. 4th 322 (2004)).

¹⁵⁹ *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400 (2001).

¹⁶⁰ *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007).

¹⁶¹ Gionfriddo, whose major league career totaled 226 games over four seasons primarily with the Brooklyn Dodgers, is best remembered for his spectacular catch of a drive off the bat of New York Yankees' Joe DiMaggio in Game Six of the 1947 World Series.

¹⁶² *See Gionfriddo*, 94 Cal. App. 4th at 413-16.

¹⁶³ *See id.* at 411. The court held that such usage was protected by section 3344 of the California Civil Code and the constitutional protection of freedom of expression; as such, it did not rise to the level of commercial speech.

In seeking to distinguish their case, the plaintiffs in *Spitz* argued that the players in *Gionfriddo* had not made claims that their names and statistics appeared in the context of advertising; nor had they shown that MLB's usage damaged their marketability.¹⁶⁴ Instead, they argued that Samsung's use of their names and images were clearly in a commercial context.¹⁶⁵ The plaintiffs pointed to the fact that Samsung's name and logo were displayed on every page of the app, there were links to Samsung's corporate website, and there were games and quizzes that promised discounts on Samsung's products (although this feature was disabled before the official launch of the app).¹⁶⁶ In arguing that the app amounted to commercial speech, the plaintiffs also alleged that the app's main purpose was to enhance Samsung's brand identity.¹⁶⁷

Judge Kwan also relied heavily on the Eighth Circuit decision in *CBC*, in which the plaintiff marketer of online fantasy baseball games sought declaratory judgment regarding its right to use MLB player names, statistics, and other biographical information.¹⁶⁸ The Eighth Circuit upheld *CBC*'s right to use this information, ruling that "the information used in *CBC*'s fantasy baseball games is all readily available in the public domain, and it would be a strange law

¹⁶⁴ Opposition to Motion to Strike, *supra* note 149, at 11–12. Given the roster of nondescript players who joined *Gionfriddo* in this lawsuit, it is arguable that, to the extent that any of these plaintiffs had marketability, it was limited at best.

¹⁶⁵ *Id.* at 12. Arguably, one key distinguishing factor overlooked by Judge Kwan is that Samsung was the *sole* advertiser in the Genome Project App, whereas the game program at issue in *Gionfriddo* included multiple advertisers.

¹⁶⁶ *Id.* There were a number of features that were disabled before the launch of the app. Judge Kwan held that any features that may have been contemplated, but were not activated, were irrelevant for dispensation of the case.

¹⁶⁷ *Id.* at 8.

The plain facts . . . establish the commercial purpose of the application. All of those pages contain Samsung's name and logo Incredibly, both Samsung and Team Epic admit that the purpose of the Application was to enhance Samsung's brand identity. In paragraph 3 of Doug Hall's declaration . . . he admits that a goal of the Application was to "increase Samsung's profile among users of social media."

Id. at 8–9.

¹⁶⁸ *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 820 (8th Cir. 2007). For an alternative analysis of the court's decision in *CBC*, see David G. Roberts Jr., *The Right of Publicity and Fantasy Sports: Why the CBC Distribution Court Got It Wrong*, 58 CASE W. RES. L. REV. 223 (2007).

that a person would not have a First Amendment right to use information that is available to everyone.”¹⁶⁹ The Eighth Circuit further found that “the facts in this case barely, if at all, implicate the interests that states typically intend to vindicate by providing rights of publicity to individuals.”¹⁷⁰ Despite the factual differences between *Spitz*, *Gionfriddo*, and *CBC*, Judge Kwan affirmed the “significant public interest in the Olympics and the athletes involved in the Olympics”¹⁷¹ and thus fell within California’s statutory “public affairs” exemption as set forth in:

[T]he “use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, . . . shall not constitute a use for which consent is required under subdivision (a) ‘Public affairs’ is largely interpreted to “include things that would not necessarily be considered news” and “was intended to mean something less important than news.”¹⁷²

Finally, Judge Kwan stated that the plaintiffs did not “present admissible evidence showing that the Olympic Genome Project’s use of their names, images and biographical information impaired their economic interest. To the contrary, it is equally likely that Plaintiffs’ marketability was enhanced by the presentation of their names, images and biographical information on the Olympic Genome Project.”¹⁷³

In order to rule on the anti-SLAPP motion, the linchpin question before Judge Kwan was whether the speech conveyed in the Genome Project App constituted noncommercial speech (thus fall-

¹⁶⁹ *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d at 823.

¹⁷⁰ *Id.* at 824.

¹⁷¹ *Spitz*, 2013 WL 6816181, at *2.

¹⁷² CAL. CIV. CODE § 3344(d) (West 2012). Courts have applied the “public affairs” exception to protect an extensive variety of sports-related entertainment and expressive works. *See, e.g., C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d at 818 (applying exception to baseball websites); *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400 (2001) (applying exception to game programs); *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790 (1995) (applying exception to posters inserted into newspapers and magazines); *Dora v. Frontline Video, Inc.*, 15 Cal. App. 4th 536 (1993) (applying exception to a surfing documentary).

¹⁷³ *Spitz*, 2013 WL 6816181, at *2 (citing *Gionfriddo*, 94 Cal. App. 4th 400).

ing within the scope of the anti-SLAPP statute), or instead should be classified as commercial (or a mix of both).¹⁷⁴ Judge Kwan held that the speech at issue was noncommercial and thus fully protected speech under the First Amendment. In arriving at this decision, Judge Kwan heavily relied on *Rezec v. Sony Pictures Entertainment, Inc.*¹⁷⁵ and the district court decision in *Jordan I.*¹⁷⁶ In *Rezec*, the motion picture company depicted in its advertising campaign laudatory reviews that were attributed to a non-existent film critic that were alleged to be false.¹⁷⁷ Although the *Rezec* court found that the film enjoyed complete First Amendment protection, the advertisement itself did not. In distinguishing *Rezec*, Judge Kwan stated that “the Olympic Genome Project does not contain false content, nor does it influence potential Facebook users to purchase specific Samsung products.”¹⁷⁸

Judge Kwan held that, unlike *Rezec*, the Genome Project was not a case that involved false advertising.¹⁷⁹ Furthermore, the Genome Project did not contain advertisements specifically for particular Samsung products, did not have a click-through to Samsung’s main website, and did not offer gaming where Facebook users or consumers could earn discounts on Samsung’s product. The linchpin for Judge Kwan’s decision was the lack of any “call to action” to purchase specific Samsung products.¹⁸⁰ Hence, while the deceitful movie reviews advertised in the *Rezec* case could have likely induced potential moviegoers to purchase tickets, there was nothing in the Genome Project that, as determined by Judge Kwan, could or would serve to induce users of the app to purchase Samsung products.¹⁸¹ Judge Kwan also relied heavily on the district court opinion in *Jordan I.*¹⁸² Before discussing Kwan’s rationale, an overview of the facts of *Jordan I* is warranted.

¹⁷⁴ *See id.*

¹⁷⁵ *Rezec v. Sony Pictures Entm’t, Inc.*, 116 Cal. App. 4th 135 (2004).

¹⁷⁶ *Jordan I*, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), *rev’d*, 743 F.3d 509 (7th Cir. 2014).

¹⁷⁷ *Rezec*, 116 Cal. App. 4th at 137.

¹⁷⁸ *Spitz*, 2013 WL 6816181, at *2.

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.*

¹⁸² *Id.* at 2–3.

A. Jordan I Background

In 2009, Michael Jordan was inducted into the Basketball Hall of Fame.¹⁸³ *Sports Illustrated* produced a special commemorative issue that exclusively featured Jordan's career.¹⁸⁴ The issue was not distributed to magazine subscribers, but was instead sold in stores. The defendant, operator of Chicago area grocery chain Jewel-Osco, was provided a free full-page ad in the magazine in exchange for selling the issue in its stores.¹⁸⁵ The congratulatory ad was placed on the inside back cover of the magazine; it featured an image of a pair of sneakers featuring Jordan's number "23," and text that read:

A Shoe In! After six NBA championships, scores of rewritten record books and numerous buzzer beaters, Michael Jordan's elevation in the Basketball Hall of Fame was never in doubt! Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was "just around the corner" for so many years.¹⁸⁶

Under this text, the ad also featured Jewel-Osco's registered trademark logo and its marketing slogan, "Good things are just around the corner."¹⁸⁷

In response, Jordan sued Jewel-Osco alleging, inter alia, violations of the Illinois Right of Publicity Act.¹⁸⁸ The district court be-

¹⁸³ See *Hall of Famers*, NAISMITH MEMORIAL BASKETBALL HALL OF FAME, <http://www.hoophall.com/hall-of-famers-index/> [<https://perma.cc/28FP-T2JF>] (last visited May 22, 2016).

¹⁸⁴ *Jordan I*, 851 F. Supp. 2d 1102, 1104 (N.D. Ill. 2012), *rev'd*, 743 F.3d 509 (7th Cir. 2014).

¹⁸⁵ *Id.*

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ 765 ILL. COMP. STAT. ANN. 1075/5 (2016).

As used in this Act: "Commercial purpose" means the public use or holding out of an individual's identity (i) on or in connection with the offering for sale or sale of a product, merchandise, goods, or services; (ii) for purposes of advertising or promoting products, merchandise, goods, or services; or (iii) for the purpose of fundraising. "Identity" means any attribute of an individual that serves to identify that individual to an ordinary,

gan its analysis by stating that “[a] significant and potentially dispositive issue”¹⁸⁹ was whether Jewel-Osco’s advertisement was noncommercial speech, which would receive full First Amendment protection, or “commercial speech,” which would receive lesser protection.¹⁹⁰ In siding for the defendant, the district court first noted that “the test for identifying commercial speech”¹⁹¹ turns on whether the speech proposed a commercial transaction.¹⁹² The district court stated:

It is difficult to see how Jewel’s page could be viewed, even with the benefit of multiple layers of green eyeshades, as proposing a commercial transaction. The text recounts some of Jordan’s accomplishments and congratulates him on his career and induction into the Hall of Fame. The shoes, the number 23, and the hardwood floor evoke Jordan and the sport and team for which he enjoyed his principal success. . . . At the most basic level, the page does not propose any kind of commercial

reasonable viewer or listener, including but not limited to (i) name, (ii) signature, (iii) photograph, (iv) image, (v) likeness, or (vi) voice.

Id.

Jordan also alleged violations of the Lanham Act (15 U.S.C. § 1125(a) (2012)), the Illinois Consumer Fraud and Deceptive Business Practices Act (815 ILL. COMP. STAT. ANN. 505/1 (2007)), and the common law tort of unfair competition. *Jordan I*, 851 F. Supp. 2d at 1102.

¹⁸⁹ *Jordan I*, 851 F. Supp. 2d at 1105.

¹⁹⁰ *See* Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y., 447 U.S. 557, 561–63 (1980) (holding that whether speech is to be classified as commercial or noncommercial is a matter of law to be decided by the court); *see also* Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 65 (1983).

¹⁹¹ *Jordan I*, 851 F. Supp. 2d at 1106 (citing *City of Cincinnati v. Discovery Network, Inc.* 507 U.S. 410 (1993)).

¹⁹² *Id.* The court, in endeavoring to define commercial speech, also relied on *Board of Trustees of State University of New York v. Fox*, 492 U.S. 469 (1989), and *Sorrell v. IMS Health, Inc.*, 131 S. Ct. 2653 (2011). *See Fox*, 492 U.S. at 482 (citing *Sorell*, 131 S. Ct. at 2674 (referencing the “commonsense distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech”)); *Va. State Bd. of Pharm. v. Va. Citizens Consumers Council, Inc.*, 425 U.S. 748, 761 (“[S]peech that *proposes* a commercial transaction . . . is what defines commercial speech.”)).

transaction, as readers would be at a loss to explain what they have been invited to buy.¹⁹³

Hence, the judge ruled that Jewel-Osco's congratulatory advertisement was protected free speech, holding that the ad was a work in service of honoring and congratulating Jordan: a "tribute by an established Chicago business to Chicago's most accomplished athlete."¹⁹⁴ The court further held that there was no profit motivation to commercially exploit the Jordan brand since Jewel-Osco was not compensated by TIME, Inc. for having created the ad.¹⁹⁵

B. Spitz Court's Application of Jordan I

Likewise, in Judge Kwan's judgment, one could not argue that Samsung, despite the presence of its corporate logo and slogan, was engaged in anything more than a simple "proposal" of a commercial transaction because no specific Samsung products were advertised or promoted in the Genome Project.¹⁹⁶ Analogous to the rationale in *Jordan I*, Samsung did not specifically encourage consumers to go to a consumer electronics store or to go online to purchase Samsung products.¹⁹⁷ Judge Kwan conceded, while citing to *Jordan I*, that "even if the display of the Samsung logo could somehow be viewed as introducing minimal elements of commercialism, those elements are intertwined with and overwhelmed by the message's non-commercial aspects, thereby rendering the entirety of the Olympic Genome Project non-commercial."¹⁹⁸

¹⁹³ *Jordan I*, 851 F. Supp. 2d at 1106-07.

¹⁹⁴ *Id.* at 1110-11.

¹⁹⁵ *See id.* at 1111.

¹⁹⁶ *See id.*

¹⁹⁷ Opposition to Motion to Strike, *supra* note 149. The plaintiffs argued that the Genome Project App was clearly intended to drive sales of Samsung products and to enhance Samsung's brand awareness with consumers. They further argued that Samsung used the athlete's names and images without approval with the intent of creating the impression that Plaintiffs were endorsers of Samsung's products and business.

¹⁹⁸ *Spitz v. Samsung Elecs. Am., Inc.*, No. BC 483475, 2013 WL 6816181, at *2 (Cal. Super. Ct. Jan. 10, 2013). Similarly, the district court in *Jordan I* recognized that even if the presence of the store's slogan in the advertisement ("Just Around the Corner") could be arguably perceived as presenting some nominal commercial components, that element was intermingled with the message's noncommercial elements, consequently transforming the entire advertisement into noncommercial speech. *Jordan I*, 851 F. Supp. 2d at 1108.

Judge Kwan thus held that users exploring Samsung's Facebook app would be unlikely to believe that they were being invited to purchase any Samsung products.¹⁹⁹ Further, she held that the fact that Samsung might have acted with economic motivation in generating the Genome Project did not, in and of itself, render the Facebook app commercial speech.²⁰⁰ Nor, she held, did Jewel-Osco's economic motivation for generating and placing its page in the commemorative issue transform its congratulatory advertisement into commercial speech.²⁰¹

The plaintiffs argued that noncommercial "public interest" protected speech, when *mixed* with commercial speech, was not protected by the anti-SLAPP statute or by the Constitution.²⁰² In addition, the athletes asserted that the app's use of their name and image could not be protected since it improperly inserted public interest information with product and brand advertising.²⁰³ The plaintiffs relied in particular on *Downing v. Abercrombie & Fitch*.²⁰⁴

In 1999, surfers George Downing, Paul Strauch, Rick Steere, Richard Buffalo Keaulana, and Ben Aipa sued Abercrombie & Fitch, alleging the apparel company had misappropriated their names and likenesses for commercial use.²⁰⁵ In this case, a picture featuring the plaintiffs engaged in a surfing competition held over thirty years prior was used by Abercrombie & Fitch in its catalog.²⁰⁶ The defendants argued, on the basis of the First Amendment, that the photograph illustrated an article about surfing, a matter of public interest.²⁰⁷ The court held, however, that "there is a tenuous relationship between [the] photograph and the theme presented. Abercrombie used [the] photograph essentially as window dressing to advance the catalog's surf theme" and thus not protected by the First Amendment.²⁰⁸

¹⁹⁹ *Spitz*, 2013 WL 6816181, at *2.

²⁰⁰ *Id.*

²⁰¹ *Id.*

²⁰² Opposition to Motion to Strike, *supra* note 149, at 2.

²⁰³ *Id.*

²⁰⁴ *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

²⁰⁵ *Id.* at 999.

²⁰⁶ *Id.* at 1000.

²⁰⁷ *Id.* at 1002.

²⁰⁸ *Id.*

In opposition to the defendants' argument that there was no direct connection between the alleged use of the Olympic athletes and the commercial purpose, the plaintiffs argued that the defendants had conceded an economic motivation for the app (specifically, to enhance Samsung's brand image). Moreover, as the plaintiffs pointed out, citing *Downing*, "the Court never discussed whether there was a direct connection between the use of the picture and the defendant's economic motivation, but implicitly found one, because it upheld the plaintiffs' claim, even though the plaintiffs were never even identified in the catalog."²⁰⁹ According to the plaintiffs' claim, it was not an important issue whether or not there was direct connection between the use of the athletes' picture and the commercial purpose in *Downing*.²¹⁰ According to the Court's decision in *Downing*, in addition, the use of the picture was held to not be protected as a matter of public interest and Abercrombie & Fitch could not be entitled to allege a First Amendment defense.²¹¹ For these reasons, the defendants in *Spitz* argued that *Downing* did not apply to the Genome Project because of the indirect connection between the use of the athletes and the defendants' economic motivation.²¹²

The plaintiffs also relied on *Kasky*²¹³ in arguing that Samsung's Genome Project should be classified as commercial speech.²¹⁴ However, Judge Kwan determined that the *Kasky* decision, like that in *Downing*, was in essence a false advertising case: "In contrast [to Nike] . . . the Olympic Genome Project does not make any representation of fact about Samsung's products, does not promote specific Samsung products, and does not make any representations of fact about Samsung's business, let alone representations alleged to be false."²¹⁵ Having thus determined that (1) Samsung's Facebook app constituted public interest speech, (2) such speech was noncommercial in nature, and (3) the plaintiffs were unlikely to

²⁰⁹ Opposition to Motion to Strike, *supra* note 149, at 11.

²¹⁰ *Id.*

²¹¹ *Downing*, 265 F.3d at 1002.

²¹² Opposition to Motion to Strike, *supra* note 149, at 11.

²¹³ See *supra* notes 125–35 and accompanying text.

²¹⁴ Opposition to Motion to Strike, *supra* note 149, at 11.

²¹⁵ *Spitz v. Samsung Elecs. Am., Inc.*, No. BC 483475, 2013 WL 6816181, at *2 (Cal. Super. Ct. Jan. 10, 2013).

succeed on the merits of the case, Judge Kwan upheld the defendants' anti-SLAPP motion.²¹⁶

IV. *JORDAN II*: SEVENTH CIRCUIT FINDS “IMAGE ADVERTISING”

In February 2014, the Seventh Circuit overruled the lower court in holding that Jewel-Osco's congratulatory advertisement amounted to commercial speech, and thus remanded the case back to the lower court to determine Jordan's claims and damages.²¹⁷ The Seventh Circuit began by acknowledging that the Supreme Court has generally “worked out” the commercial speech doctrine in public law cases,²¹⁸ while noting that the Jordan case involved a “clash of private rights.”²¹⁹

²¹⁶ *Id.* at *3.

²¹⁷ *Jordan II*, 743 F.3d 509, 512 (7th Cir. 2014). The Seventh Circuit acknowledged that the issue before it was simply whether the advertisement in question should be classified as commercial or noncommercial speech. The Seventh Circuit elaborated, however, that even if the ad is held to be noncommercial speech, “it is far from clear that Jordan's trademark and right-of-publicity claims fail without further ado.” *Id.* at 514. Citing renowned trademark expert McCarthy, and the fact that the Supreme Court has yet to address this issue, the Seventh Circuit added that “there is a no judicial consensus on how to resolve conflicts between intellectual-property rights and free-speech rights; instead the courts have offered ‘a buffet of various legal approaches to [choose] from.’” *Id.* (citing 6 MCCARTHY, *supra* note 28, § 31.139).

²¹⁸ Such cases have included: a challenge to a municipal ban on distribution of commercial publications on newsstands on public property (*City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410 (1993)); a challenge to a public university's ban on “Tupperware”-style housewares parties in dormitories (*Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469 (1989)); a challenge to a state statute regulating fees charged by professional charitable fundraisers (*Riley v. Nat'l Fed'n of the Blind of N.C.*, 487 U.S. 781 (1988)); a challenge to a federal statute prohibiting the mailing of unsolicited contraceptive advertisements (*Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983)); a challenge to a state regulation banning promotional advertising by utilities (*Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980)); and a challenge to a state statute prohibiting pharmacists from advertising the prices of prescription drugs (*Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976)).

As noted by the Seventh Circuit, in the public-law context, “the commercial/noncommercial classification determines the proper standard of scrutiny to apply to the law or regulation under review in the case.” *Jordan II*, 743 F.3d 509, 514 (7th Cir. 2014).

²¹⁹ *Jordan II*, 743 F.3d at 514.

The Seventh Circuit's decision turned on two issues: (1) how to define the scope of commercial speech and (2) how to handle advertising that contains elements of both commercial and non-commercial speech. Regarding the first issue, the court first acknowledged the accepted definition of commercial speech: "[S]peech that does *no more than* propose a commercial transaction 'fall[s] within the core notion of commercial speech . . .'"²²⁰ However, as the court continued, "other communications may also represent commercial speech despite the fact that they contain discussions of important public issues."²²¹

The Seventh Circuit was specifically challenged with how to classify speech that contained both commercial and noncommercial elements, as was deemed to be the case here.²²² The court first turned to *Bolger*,²²³ which provides three guideposts for classifying speech that contains both commercial and noncommercial elements, including "whether (1) the speech is an advertisement, (2) the speech refers to a specific product, and (3) the speaker has an economic motivation for the speech."²²⁴ As the court elaborated: "This is just a general framework, however; no one factor is sufficient, and *Bolger* strongly implied that all are not necessary."²²⁵ Still, the core of the court's analysis focused on the second element

²²⁰ *Id.* at 516 (citing *Bolger*, 463 U.S. at 66).

²²¹ *Id.* (citing *Fox*, 492 U.S. at 475). The Seventh Circuit added that the Supreme Court has "made clear that advertising which links a product to a current public debate is not thereby entitled to the constitutional protection afforded noncommercial speech." *Id.* (citing *Zauderer v. Office of Disciplinary Counsel of the Sup. Ct. of Ohio*, 471 U.S. 626, 637 (1985)).

²²² *Id.* at 517. The Seventh Circuit used *Jordan II* as an opportunity to clarify the proper use of the "inextricably intertwined" doctrine, which the district court had relied upon in holding for Jewel-Osco. *Id.* at 520. The court writes: "That doctrine holds that when commercial speech and noncommercial speech are inextricably intertwined, the speech is classified by reference to the whole; a higher degree of scrutiny may be applied if the relevant speech 'taken as a whole' is properly deemed noncommercial." *Id.* (citing *Fox*, 492 U.S. at 474). The Seventh Circuit, in arguing that the court in *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001), misapplied the doctrine, went on to suggest that it is difficult to identify a scenario in which both commercial and noncommercial speech could be "inextricably intertwined": "No law of man or nature compelled Jewel to combine commercial and noncommercial messages as it did here." *Id.* at 522.

²²³ *Bolger*, 463 U.S. 60 (1983).

²²⁴ *Jordan II*, 743 F.3d at 517.

²²⁵ *Id.*

of the *Bolger* test.²²⁶ Although Jewel-Osco argued that its advertisement did not propose a commercial transaction because it did not promote a specific product or service, the Seventh Circuit took an entirely different view:

The notion that an advertisement counts as “commercial” only if it makes an appeal to purchase a particular product makes no sense today, and we doubt that it ever did. An advertisement is no less “commercial” because it promotes brand awareness or loyalty rather than explicitly proposing a transaction in a specific product or service. Applying the “core” definition of commercial speech too rigidly ignores this reality. Very often the commercial message is general and implicit rather than specific and explicit.²²⁷

It was clear, the Seventh Circuit held, that the text of the advertisement was indeed “a congratulatory salute to Jordan.”²²⁸ However, the court focused on *context* of the advertisement, which included Jewel’s own graphic logo and slogan, by stating: “[I]f the literal import of the words [in the ad] were all that mattered, this celebratory tribute would be noncommercial. But evaluating the text requires consideration of the context Modern commercial advertising is enormously varied in form and style.”²²⁹ Hence, in adopting a broader interpretation of the term “commercial,” the court held that “an advertisement is no less ‘commercial’ because it promotes brand awareness or loyalty rather than explicitly proposing a transaction in a specific product or service.”²³⁰

The Seventh Circuit stressed that while the proposing of specific commercial transactions are at the “core” of commercial speech, such propositions do not demarcate the outer limits of

²²⁶ *Id.* at 519.

²²⁷ *Id.* at 518.

²²⁸ *Id.* at 517–18. The court rejected Jewel-Osco’s argument that this advertisement was similar to others that Jewel-Osco had released in the past, which celebrated the work of local civic groups. *Id.* at 518.

²²⁹ *Id.* at 517–18.

²³⁰ *Id.* at 518.

what is commercial speech.²³¹ Rather, even if speech does something more than (or in addition to) proposing a commercial transaction, it can still be commercial.²³² As the court stated, Jewel-Osco's advertisement served two functions: (1) congratulating Jordan, and (2) enhancing Jewel's brand by associating itself with Jordan in the minds of basketball fans and Chicago consumers.²³³ Given that a "common-sense distinction" between commercial and noncommercial speech was proper, in this context, the court had to account for the varied, often subtle forms of modern advertising.²³⁴ Thus, an ad's failure to refer to a specific product was held to be relevant, but not dispositive.²³⁵ The court had no trouble answering the question, "What does [the ad] invite the readers to buy?"²³⁶ The answer: "Whatever they need from a grocery store."²³⁷ Hence, the Seventh Circuit ruled that this kind of brand advertising is not any less commercial than product advertising, since its "commercial nature is readily apparent" and it was "aimed at promoting goodwill for the Jewel-Osco brand by exploiting public affection for Jordan."²³⁸ However sincere its congratulations, the court reasoned, Jewel-Osco still "had something to gain" from the ad.²³⁹

The Seventh Circuit decision found particular significance in the characteristics and relevance of the logo and slogan as presented in the advertisement:

Jewel-Osco's graphic logo and slogan appear just below the textual salute to Jordan. The bold red logo is prominently featured in the center of the ad and in a font size larger than any other on the page. Both the logo and the slogan are styled in their trademarked

²³¹ *Id.* at 516.

²³² *Id.* at 518.

²³³ *Id.*

²³⁴ *Id.* at 517–18.

²³⁵ *Id.* at 518.

²³⁶ *Id.*

²³⁷ *Id.*

²³⁸ *Id.*

²³⁹ *Id.* at 520. The court also noted the fact that the trade deal between Jewel-Osco and Sports Illustrated, in which the former received a free full-page advertisement in exchange for selling the magazine in its stores, provided a clear economic benefit for Jewel-Osco. *Id.* at 519–20.

ways. Their style, size, and color set them off from the congratulatory text, drawing attention to Jewel-Osco's sponsorship of the tribute.²⁴⁰

The Seventh Circuit stated that the linkage that Jewel-Osco created between their logo, slogan, and Jordan as "a fellow Chicagoan who was 'just around the corner' for so many years" was used to promote shopping at Jewel-Osco stores.²⁴¹ The Seventh Circuit added that "[e]ven though the commercial nature of the ad may be generic and implicit, it is clear that it is a form of *image advertising*, which promotes goodwill for the Jewel-Osco brand "by exploiting public affection for Jordan at an auspicious moment in his career."²⁴² The court defined image advertising as a "form of advertising featur[ing] appealing images and subtle messages alongside the advertiser's brand name or logo with the aim of linking the advertiser to a particular person, value, or idea in order to build goodwill for the brand."²⁴³ In other words, congratulating Jordan on his induction into the Hall of Fame seemed reasonable, but "considered in context, and without the rose-colored glasses, Jewel's ad has an unmistakable commercial function: enhancing the Jewel-Osco brand in the minds of consumers. This commercial message is implicit but easily inferred, and is the dominant one."²⁴⁴ The Seventh Circuit went on to expand the *Bolger* test noting that the Supreme Court foreshadowed that while the failure to reference a specific product is a relevant consideration in the commercial-speech determination, it is far from dispositive, especially where "image" or brand advertising rather than product advertising is concerned.²⁴⁵

In remanding the case back to the district court, the Seventh Circuit took the opportunity to also clarify the district court's misapplication of the "inextricably intertwined" doctrine.²⁴⁶ Jordan argued that the "inextricably intertwined" doctrine was not appli-

²⁴⁰ *Id.* at 518.

²⁴¹ *Id.*

²⁴² *Id.* (emphasis added).

²⁴³ *Id.* at 520.

²⁴⁴ *Id.* at 518–19.

²⁴⁵ *Id.* at 519 (citing *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66–67 (1983)).

²⁴⁶ *Id.* at 520–21.

cable to this case.²⁴⁷ Specifically, Jordan argued that the district court had erroneously concluded that *any* advertisement that has a combination of both commercial and noncommercial speech should be deemed noncommercial speech because they are “inextricably intertwined” and cannot be separated out.²⁴⁸

The Seventh Circuit, in concurring with *Jordan I*, held that the “central inquiry [was] not whether the speech in question combines commercial and noncommercial elements, but whether it was legally or practically impossible for the speaker to separate them.”²⁴⁹ It thus held that a single presentation that combines commercial and noncommercial elements does not automatically make the speech noncommercial.²⁵⁰ Furthermore, the Court concluded that the district court wrongly relied on a Ninth Circuit’s decision in *Hoffman v. Capital Cities/ABC, Inc.*²⁵¹ that itself misapplied the “inextricably intertwined” doctrine.²⁵² According to the Seventh Circuit, the commercial and noncommercial elements of the Jewel-Osco ad were not “inextricably intertwined”: “No law of man or nature compelled Jewel to combine commercial and noncommercial messages as it did here.”²⁵³ As a result, the district court should not have held that the commercial speech in the congratulatory advertisement was so intertwined with the noncommercial speech that they could not be separated.²⁵⁴ Jewel-Osco was not compelled by government regulation to incorporate the commercial speech in the advertisement and, thus, the “inextricably intertwined” doctrine was held not applicable.²⁵⁵

²⁴⁷ *Id.* at 521.

²⁴⁸ *Id.*

²⁴⁹ *Id.* (citing *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469 (1989)).

²⁵⁰ *Id.*

²⁵¹ *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001).

²⁵² *Id.* In *Hoffman*, actor Dustin Hoffman sued a magazine publisher for misappropriating his identity. Specifically, a fashion article featured movie stills that had been altered to make it appear as though the actors were modeling clothing from famous designers. *Id.* at 1183. Dustin Hoffman in his role in the film “Tootsie” was included in the article. The Ninth Circuit held that the article was fully protected noncommercial speech, because any commercial aspects are “inextricably intertwined” with expressive elements and, therefore, cannot be separated out. *Id.* at 1185.

²⁵³ *Jordan II*, 743 F.3d at 522.

²⁵⁴ *See id.*

²⁵⁵ *Id.*

As the court concluded:

A contrary holding would have sweeping and troublesome implications for athletes, actors, celebrities, and other trademark holders seeking to protect the use of their identities or marks Classifying this kind of advertising as constitutionally immune non-commercial speech would permit advertisers to misappropriate the identity of athletes and other celebrities with impunity.²⁵⁶

As a result, the Seventh Circuit remanded the case for further proceedings, thus giving Jordan the green light to resume pursuit of his right of publicity claim in which he sought five million dollars in damages,²⁵⁷ and the parties eventually settled.²⁵⁸

V. DISCUSSION

The *Spitz* and *Jordan* cases have added yet another tile to the mosaic of competing rights. On one side of the scales of justice, we have the athlete's right to control the form and manner in which his or her name, image and likeness (otherwise referred to a persona or identity) are used without authorization for the "purposes of trade." On the other side, we have the First Amendment protections accorded by the right of free speech and expression. Adding further complexity to this balancing act is an ongoing quandary over how to define and distinguish non-commercial speech from commercial speech, particularly within the context of today's modern image (or so-called brand) advertising. The increasing dominance of digital media as a platform for image advertising only portends, as suggested by Gervais and Holmes, escalating challenges.²⁵⁹ The Seventh Circuit decision in *Jordan I*, while creating some clarity and guidelines for future brand marketers, also leaves

²⁵⁶ *Id.* at 520.

²⁵⁷ Rovell, *supra* note 12.

²⁵⁸ See Seidel, *supra* note 16.

²⁵⁹ See Gervais & Holmes, *supra* note 80, at 183. Indeed, one can wonder the outcome if Jewel-Osco's creative congratulatory message was communicated on its Twitter or Facebook account as opposed to in the pages of Sports Illustrated? Would the delivery vehicle, or ephemerality, matter?

us with yet another wrinkle, particularly when viewed alongside the court's holding in *Spitz*.²⁶⁰

Courts and commentators continue to grapple with ways to articulate clear and generally applicable guidelines to resolve this conflict.²⁶¹ Beyond the well-established triumvirate enunciated by the various courts for use in analyzing expressive mediums (the transformative use, relatedness (or Rogers) and predominant use tests),²⁶² legal scholars have also proposed a plethora of novel approaches for balancing these important interests, the premise of which was appropriately suggested by one legal scholar: “[A] vague variety of tests must not be allowed to result in situations where public figures can turn their right of publicity into a right of censorship.”²⁶³ While not within the scope of this Article, it is worth noting a few of the prevailing themes, some of which naturally overlap: (1) a focus on the “primary motivation” of the plaintiff, including but not limited to the speaker’s economic motivations;²⁶⁴ (2) a fo-

²⁶⁰ The authors readily acknowledge differences in the advertising campaigns: Samsung’s campaign utilizes the images of multiple athletes in connection with the publicly available statistical and biographical information, while the Jordan case involves the use of a single athlete in a congratulatory ad context. This, however, does not alter the fact that both campaigns were image advertising-based, and the decisions in both cases premised on a determination of what constitutes noncommercial versus commercial speech.

²⁶¹ See Volokh, *supra* note 92, at 929–30 (“The right of publicity may seem intuitively appealing to many people. The notion that my name and likeness are my property seems to make sense. But, when applied to expression, ‘my property’ is another way of saying ‘legally forbidden to be another’s speech.’”); see also W. Mack Webner & Leigh Ann Linquist, *Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment*, 37 AKRON L. REV. 171, 179–80 (2004) (“As the Right of Publicity has become a more familiar cause of action, pleading of First Amendment defenses has increased and let to an unfortunate friction between these rights.”).

²⁶² See Lee, *supra* note 71.

²⁶³ Thomas E. Kadri, *Fumbling the First Amendment: The Right of Publicity Goes 2–0 Against Freedom of Expression*, 112 MICH. L. REV. 1519, 1527 (2014).

²⁶⁴ See Brandon, *supra* note 100 (discussing the Jordan district court decision and presciently predicting the Seventh Circuit rationale in overturning the same); see also Gloria Franke, *The Right of Publicity vs. The First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. REV. 945 (2006); Gil Peles, *The Right of Publicity Gone Wild*, 11 UCLA ENT. L. REV. 301 (2004) (proposing a test resembling copyright’s fair use doctrine that incorporates a transformative factor and the Second Circuit’s “newsworthy” test, as set forth in *Titan Sports v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989), premised on the question of whether the economic value derives from the artistic expression or the celebrity). *But see* Redish & Shust, *supra* note 63, at 1481, 1488

cus on the degree of bad faith intent, or malice, of the defendant;²⁶⁵ (3) a focus on the type of medium used;²⁶⁶ and (4) a focus on a rationale of consumer confusion premised upon the application of trademark law principles to such cases.²⁶⁷

In *Spitz*, the court held that a brand advertising campaign incorporating athletes' names and likenesses is noncommercial speech because the campaign does not promote a *specific* product or service. The court in *Spitz*, relying heavily on *Jordan I*, ruled that the logo "Created by Samsung" was used simply to identify Samsung as the company responsible for the creation of the Olympic Genome Project.²⁶⁸ It held, further, that even if the logo introduced "minimal elements of commercialism, those elements are intertwined with and overwhelmed by the message's non-commercial

(arguing that the Seventh Circuit's decision in *Jordan II* discriminates against speech solely on the basis of the speaker's profit motivation: "[A]pplication of the foundational theory of modern commercial speech doctrine to the right of publicity underscores the starkly irrational nature of the rationale for such reduced protection. Simply put, commercial speech receives reduced protection for no reason other than the profit motivation behind it. . . . In no other area of free speech law do we turn decisions exclusively on a speaker's motivation.").

²⁶⁵ See, e.g., Conrad, *supra* note 63, at 795-98. "[T]o avoid a chilling effect on the First Amendment, it is time to create a new sense of balance that limits one's property rights to the situation in which they were intended: sole commercial purpose." *Id.* at 809.

²⁶⁶ See, e.g., Russell S. Jones, Jr., *The Flip Side of Privacy: The Right of Publicity, The First Amendment, and Constitutional Line Drawing—A Presumptive Approach*, 39 CREIGHTON L. REV. 939 (2006).

A court should ask, first, what is the "medium" at issue: is it plainly merchandise or a product, sold and marketed as such, such that its commercial value comes exclusively (or almost exclusively) from the celebrity's name or likeness . . . ? If so, there would be a presumption that the right of publicity would prevail over any First Amendment or free speech defense In order for the First Amendment to win out, the defendant would have to make a strong enough showing that his or her purpose was informative or expressive, not exploitative, to convince the court to overcome the presumption.

Id. at 958.

²⁶⁷ See, e.g., Stacey L. Dolgan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 116 (2006); Susannah M. Rooney, *Just Another Brown-Eyed Girl: Toward a Limited Federal Right of Publicity Under the Lanham Act in a Digital Age of Celebrity Dominance*, 86 S. CAL. L. REV. 921 (2013).

²⁶⁸ *Spitz v. Samsung Elecs. Am., Inc.*, No. BC 483475, 2013 WL 6816181, at 3 (Cal. Super. Ct. Dec. 13, 2012) (order granting defendant Team Epic LLC's special motion to strike plaintiffs' first amended complaint pursuant to California Code of Civil Procedure section 425.16).

aspects, thereby rendering the entirety of the Olympic Genome Project non-commercial.”²⁶⁹ Hence, we see freedom of speech (the right to use information readily available in the public domain) trumping the right of publicity in the context of image advertising. In *Jordan II*, involving celebration of an athlete’s Hall of Fame achievement, the Seventh Circuit holds that an advertisement need not promote a *specific* product or service; instead, given the content-based particulars of the Jewel-Osco advertisement, it amounts to commercial speech due primarily to its classification as image advertising. In the context of the modern realities of consumer advertising, the Seventh Circuit set precedent in overturning the “inextricably intertwined” doctrine as relied upon in *Spitz* and *Jordan I*.²⁷⁰ Hence, we see the right of publicity trumping the freedom of Jewel-Osco to express itself with regard to Michael Jordan: “Congrats Michael!”

The Seventh Circuit, in assessing the facts in *Jordan II*, clearly embraced the opportunity to expand the *Bolger* test to better align with the realities of modern advertising (i.e., that a company’s image advertising serves as much a purpose of “selling” as does an advertisement for a specific product or service.²⁷¹ Indeed, the decision appears precedent-setting).²⁷² Hence, given the new import of image advertising, the Seventh Circuit decision arguably serves to

²⁶⁹ *Id.*

²⁷⁰ Based on the Seventh Circuit’s holding, *Spitz* would likely be wearing another victory medal!

²⁷¹ What is not so clear is the outcome of this case had it involved a much less famous and revered celebrity than Michael Jordan. What is also not quite clear, and serves as the basis of a novel argument posited by Redish & Shust, *supra* note 63, is why corporate advertisers should not be treated the same as traditional media companies who utilize celebrity likenesses, since both have the same profit motivation. By way of example: BMW should be able to state in a print ad that Tom Cruise drives a BMW (assuming its truthfulness) in the same way that NBC News can report this in a story. It points to a double standard that begs the question: Why could Jewel-Osco not congratulate Jordan in an ad, but TIME, Inc., owners of *Sports Illustrated*, can use Jordan’s name and likeness to create an entire magazine, sell advertising in it, and then sell the magazine itself for substantial profit? Arguably, isn’t *Sports Illustrated*’s usage much more egregious? Jordan’s induction into the Hall of Fame was no more or less timely, or newsworthy, for *Sports Illustrated* than it was for Jewel-Osco.

²⁷² A LexisNexis search for “image advertising” as commercial speech in athletes’ cases revealed no cases on point. It remains to be seen if similar doctrine will be adopted by other circuits (most notably, in light of the quick disposal of *Spitz* in California in the Ninth Circuit).

yet further expand (on the heels of the EA Sports rulings) the range of causes of action for athletes under the right of publicity doctrine.²⁷³ As a result, it becomes increasingly difficult to envision just how a company could express itself in congratulating a celebrity concerning a matter of public record *without* risking a right of publicity violation—a chilling notion. After all, only the least legally savvy of advertisers would combine a congratulatory message with a coupon.²⁷⁴ Given these factors, however, *Jordan II* does provide guidance on how this can be accomplished (at least with minimal legal risk) by establishing a continuum of sorts.

On one end of the continuum, the Seventh Circuit states that an advertisement that incorporates a brand logo and slogan is to be considered commercial in nature; the fact that it doesn't identify or promote a specific product is irrelevant in today's advertising world.²⁷⁵ On the other end, it applies a content-based analysis of Jewel-Osco's advertisement that suggests that, absent some elements and creative executions, would place it within the realm of noncommercial speech. Although the Seventh Circuit's content-specific analysis of the Jewel-Osco's advertisement arguably creates many gray areas for future advertising copywriters and layout designers, one can also view the decision as providing a roadmap for how companies *can* utilize athlete personae in advertising (particularly congratulatory messaging) without violating the right of publicity. In fact, this roadmap was proposed to the court by Jordan's legal team:

If Jewel and Supervalu merely wanted to congratulate Jordan as they claim, they easily could have done so. They could have privately congratulated Jordan. If they wanted to publicly congratulate Jordan, they could have done so without identifying themselves as speakers. And if they wanted to publicly congratulate Jordan and identify themselves as the speakers, they could have done so using their

²⁷³ See *supra* notes 60–79 and accompanying text.

²⁷⁴ See *Jordan v. Dominick's Finer Foods*, 115 F. Supp. 3d 950 (N.D. Ill. 2015).

²⁷⁵ *Jordan II*, 743 F.3d 509, 519 (7th Cir. 2014) (“Dismissing the logo and slogan as ‘mere nametags’ overlooks their value as advertising tools.”).

corporate names (Jewel Food Stores, Inc. and Supervalu).²⁷⁶

In other words, if Jewel-Osco had not prominently featured its brand logo and company slogan larger than its congratulatory messaging, had not cleverly married its slogan with Michael Jordan as (“Good things . . . just around the corner”), and had not espoused their shared geography (“fellow Chicagoans”), arguably Jordan could have been publicly congratulated within the parameters of the law. One can argue, alternatively, that the guidance for future congratulatory advertising boils down to this: creativity may kill.²⁷⁷

CONCLUSION

The Seventh Circuit’s decision in *Jordan II*, through both its novel application of the *Bolger* test and analysis of mixed-messaged speech, arguably continues the expansion of publicity rights that comes on the heels of the EA Sports line of cases. Furthermore, *Jordan II*’s embrace of “image advertising” as a proxy for advertising of *specific* products, in conjunction with the athletes’ right of publicity creates the potential chilling effect for companies and brands desiring to express themselves on matters of public interest and other newsworthy events involving athletes (including but not limited to recognition of career achievements and honors).²⁷⁸ As established by the Seventh Circuit, the consumer does not have to be invited to purchase a specific product in order for an advertisement to be deemed commercial speech. While it is not within the scope of this Article to reconcile *Jordan II* with the numerous and varied approaches to balancing commercial speech with the right of publicity doctrine,²⁷⁹ the Seventh Circuit has provided several im-

²⁷⁶ Plaintiff-Appellant Michael Jordan’s Opening Brief and Required Short Appendix at 30, *Jordan II*, 743 F.3d 509.

²⁷⁷ Indeed, one can argue, from the corporate marketer’s standpoint, that the fatal flaw in the Jewel-Osco’s congratulatory ad was simply the advertising copywriters’ desire to be clever and creative.

²⁷⁸ See Gervais & Holmes, *supra* note 80. “Indeed, the uncertainty associated with liability stemming from the right of publicity is potentially chilling speech.” *Id.* at 211–12 (noting that EA Sports, in the face of legal challenges to the game’s use of college football players, ceased production of its popular NCAA Football videogame).

²⁷⁹ See *supra* Section I.F and Part II.

portant guidelines for corporations and brands seeking to utilize athletes in advertising that would, at first glance, appear to be non-commercial in nature. First, the decision creates some degree of clarity in how closely and creatively an advertiser can align its brand messaging and indicia with the athlete. For corporations developing advertising and promotional literature, *Jordan II* further stresses the importance of reviewing advertisements for logos and other taglines, and in particular the size and location of such identifying marks in conjunction with the athlete identifiers. Jordan's \$8.9 million jury verdict against Dominick's, coupled with his additional compensation deriving from the unreported settlement with Jewel-Osco,²⁸⁰ shows that even with a congratulatory message, judges and juries may not necessarily permit companies to get away unscathed for using a player's image without permission, even if used in a non-traditional advertising context. The interplay between advertising and athletes' rights of publicity has always required a delicate balance. For the time being, *Jordan II* has at least shined a brighter line on how corporations can navigate this world while limiting liability. In the meantime, legal scholars—and corporate advertisers—can only wait and hope that guidance from the Supreme Court in crafting a structured legal framework for reconciling publicity and commercial speech rights is “just around the corner.”

²⁸⁰ See Briscoe, *supra* note 16.